

78-1868

Supreme Court, U. S.

FILED

JUN 18 1979

MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1979

No.

CENTSABLE PRODUCTS, INC.,

Plaintiff-Respondent,

v.

JEROME H. LEMELSON,

Defendant-Petitioner.

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF
APPEALS FOR THE SEVENTH CIRCUIT

Counsel of Record

ARTHUR T. FATTIBENE
28 West 44th Street
New York, New York 10036
(212) 730-1220

(For further appearances, please
see reverse side of cover.)

8047)

TABLE OF CONTENTS

Of Counsel

GLENN L. STEPHENSON
80 Park Avenue
New York, New York 10016
(212) 682-5944

GEORGE MacRAE
1725 Kirkwood Avenue
Merrick, New York 11566
(516) 378-6488

CHARLES A. RUSSELL
36 Centre Street
Concord, New Hampshire 03301
(603) 225-3185

	<u>Page</u>
Opinions Below	2
Jurisdiction	2
Questions Presented	3
Statement of the Case	4
Constitutional and Statutory Provisions Involved	8
Reasons for Granting the Writ	9
Conclusion	75
Appendix A - District Court Opinion . . .	1a
Appendix B - Opinion of the Court of Appeals	29a
Appendix C - Krusi and Chaffin Patents; Uncited Art Asserted Against Lemelson Patents.	36a
Appendix D - Art Considered and Cited By the Examiner	42a
Appendix E - Affidavit of Leonard S. Knox	50a

TABLE OF AUTHORITIES

	<u>Page</u>
A & P Tea Co. v. Supermarket Corp., 340 U.S. 147 (1950)	54
AR Inc. v. Electro-Voice Inc., 311 F.2d 508 (7th Cir. 1962)	21, 22
Adickes v. S.H. Kress & Co., 398 U.S. 144 (1970).	73
Adler Sign & Letter Co. v. Wagner Sign Service, 112 F.2d 264 (7th Cir. 1940), <u>cert. denied</u> 311 U.S. 692	19
Ag Pro, Inc. v. Sakraida, 474 F.2d 167, supplemented 481 F.2d 668, 437 F.2d 99 (5th Cir. 1971).	57, 70, 73
Anderson's Blackrock Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57, 62 (1969).	56
Artmoore Co. v. Dayless Mfg. Co., Inc., 208 F.2d 1 (7th Cir. 1953), <u>cert. denied</u> 347 U.S. 920	20
Associated Press v. U.S., 326 U.S. 1 (1944).	66
Blonder-Tongue Laboratories, Inc. v. University of Ill. Foundation, 402 U.S. 313 (1971).	35, 69

Blumcraft of Pittsburgh v. Citizens and Southern Nat'l. Bank of S.C., 407 F.2d 557 (4th Cir. 1969), <u>cert.</u> <u>denied</u> 395 U.S. 961, <u>reh. denied</u> 396 U.S. 949, 369 U.S. 870.....	26
Bouchard v. Washington, 514 F.2d 824 (D.C. Cir. 1975)	65
Cee-Bee Chemical Co., Inc. v. Delco Chemicals, Inc., 263 F.2d 150 (9th Cir. 1959)	70
Chicago Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452 (7th Cir. 1975), <u>cert. denied</u> 423 U.S. 1091. . . 24, 27, 34	
Cole v. Chevron Chemical Co., 427 F.2d 390 (5th Cir. 1970)	65, 71
Detroit Motor Appliance Co. v. Burke, 4 F.2d 118 (8th Cir. 1925).	19
Diamond International Corp. v. Maryland Fresh Eggs, Inc., 523 F.2d 113 (4th Cir. 1975)	33
Dickstein v. Seventy Corp., 522 F.2d 1294 (6th Cir. 1975), <u>cert. denied</u> 423 U.S. 1055.	34
Ever-Wear Inc. v. Weiboldt Stores, Inc., 427 F.2d 373 (7th Cir. 1970)	32

Page

Erie v. Tompkins, 304 U.S. 64 (1938) . .	35
First Nat. Bank v. Cities Service Co., 391 U.S. 253 (1967)	72
Futorian Mfg. Corp. v. Dual Mfg. and Engineering, Inc., 528 F.2d 941 (1st Cir. 1976)	32
Gettleman Mfg., Inc. v. Lawn 'N' Sport Power Mower Sales and Service, Inc., 517 F.2d 1194 (7th Cir. 1975)	22, 24
Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966)	40, 54, 62
Graver Mfg. Co. v. Linde Co., 336 U.S. 271	61
Hays v. Brenner, 357 F.2d 287 (C.A.D.C. 1966)	29
Hobbs v. Atomic Energy Comm'n., 451 F.2d 849 (5th Cir. 1971)	28, 31
Ingersoll-Rand Co. v. Brunner & Lay, Inc., 474 F.2d 491 (5th Cir. 1973), <u>cert. denied</u> 414 U.S. 865	33
Intermountain Research and Engineering Co. v. Hercules, Inc., 406 F.2d 133 (9th Cir. 1969)	70
Jamesbury Corp. v. U.S., 518 F.2d 1384 (Ct. of Cl. 1975)	62

Jaroslawicz v. Seedman, 528 F.2d 180 (8th Cir. 1975)	66, 67
Kirk v. Home Indemnity Co., 431 F.2d 554 (7th Cir. 1970)	65
L & A Products, Inc. v. Britt Tech. Corp., 223 F. Supp. 126 (8th Cir. 1966)	34
Lemelson v. Topper Corp., 450 F.2d 845 (2d Cir. 1971)	26
Moore v. Schultz, 491 F.2d 294 (10th Cir. 1974), <u>cert. denied</u> 419 U.S. 930	35
Moore Bus. Terms, Inc. v. Minn. Mining & Mfg. Co., 521 F.2d 1178 (2d Cir. 1975).	69
Morpul, Inc. v. Glen Raven Knitting Mill, Inc., 375 F.2d 732 (4th Cir. 1966)	70
National Cash Register Corp. v. East- man Kodak Co., 191 U.S.P.Q. 1941 (7th Cir. 1976)	24, 27
Polier v. Columbia Broadcasting, 368 U.S. 464 (1961).	66
Rains v. Cascade Industries, Inc., 402 F.2d 241 (9th Cir. 1968)	68

	<u>Page</u>
Rains v. Niaqua, Inc., 406 F.2d 275 (2d Cir. 1969)	32
Reiner v. I. Leon Co., 285 F.2d 501 (2d Cir. 1960)	60
Rich Products Corp. v. Mitchell Foods, Inc., 357 F.2d 176 (2d Cir. 1966).	44
Saf-Gard Products, Inc. v. Service Parts Inc., 532 F.2d 1266 (9th Cir. 1976), <u>cert. denied</u> 429 U.S. 896	29, 34
Safety Car Heating & Lighting Co., Inc. v. General Electric Co., 1555 F.2d 937, 939 (2d Cir. 1947)	60
Arthur J. Schmitt Foundation v. Stock- ham Valves & Fittings, Inc., 292 F. Supp. 893 (N.D. Ala. 1966)	44
Schnadig Corp. v. Gaines Mfg. Co., Inc., 494 F.2d 383 (6th Cir. 1974)	28
Solder Removal Co. v. United States Int'l Trade, 582 F.2d 628 (C.C.P.A. 1978)	30, 38, 41, 43
Tee-Pack, Inc. v. St. Regis Paper Co., 491 F.2d 1193 (6th Cir. 1974)	69, 70
Trio Process Corp. v. L. Goldstein's Sons, Inc., 461 F.2d 66 (3d Cir. 1972), <u>cert. denied</u> 409 U.S. 977	33

	<u>Page</u>
T.S.C. Industries, Inc. v. Northway, Inc., 426 U.S. 438 (1975)	71
U.S. v. Diebold, Inc., 369 U.S. 654 (1961)	67
Weinberger v. Hynson, Westcott & Dunning, 412 U.S. 609 (1972)	66
White Motor Co. v. U.S., 372 U.S. 253 (1963)	71
Woodstream Corp. v. Herter's Inc., 446 F.2d 1143 (8th Cir. 1971)	28, 43

Constitutional Provision

Constitution of the United States, Article I, §8, cl. 8	8
---	---

Statutes

35 U.S.C. §101	54
35 U.S.C. §103	39, 40, 54, 55
35 U.S.C. §282	6, 9, 38, 41

Other Authorities

W. B. Chaffin, U.S. Patent No. 740, 397	25
---	----

Draft Report of the Advisory Subcommittee on Patent and Information Policy of the Advisory Committee on Industrial Innovation. Directed by The Industrial Innovation Committee, chaired by Secretary of Commerce, Juanita M. Kreps. (Committee established as a part of the Domestic Policy Review, 12/20/78) 37, 50, 53

Federico's Commentary on Congressional Deference, 35 U.S.C.A. 1954. 23

M. B. Krusi, U.S. Patent No. 1,538,640. 25

Nonobviousness in Patent Law: A Question of Law or Fact? 18 WM. & MARY L. REV. 612 (1977). 57

Patent Office Manual of Practice and Examining Procedure (M. P. E. P. §904.02). 47, 51

The Presumption of Validity: A Study of Its Effect on Case Law, by David A. Lowin (P. T. C. Research Foundation of the Franklin Pierce Law Center, Concord, New Hampshire, 1979). 18

Subtests of "Nonobviousness": A Non-technical Approach to Patent Validity, 112 U. PA. L. REV. 1169 (1964). 57

Page

Victor Wigman, Letter of 10/2/78,
Wigman and Cohen, Crystal Place 1,
2001 Jefferson Davis Highway,
Arlington, Va. 22202 25

SUPREME COURT OF THE UNITED STATES

October Term, 1979

No.

CENTSABLE PRODUCTS, INC.,

Plaintiff-Respondent,

v.

JEROME H. LEMELSON,

Defendant-Petitioner.

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF
APPEALS FOR THE SEVENTH CIRCUIT

To the Honorable, the Chief Justice, and the
Associate Justices of the Supreme Court of the
United States:

Jerome H. Lemelson, your petitioner,

prays that a writ of certiorari issue to review the decision of the United States Court of Appeals for the Seventh Circuit entered in this case on January 23, 1979, rehearing denied March 19, 1979.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Seventh Circuit (Appendix A, infra, pp. 1a-28a) has been reported at 571 F.2d 400 (7th Cir. 1979). That opinion affirms the decision of the United States District Court for the Northern District of Illinois, Eastern Division (Appendix B, infra, pp. 29a-35a).

JURISDICTION

The judgment of the Court of Appeals for the Seventh Circuit was entered on January

23, 1979, rehearing denied March 19, 1979, and this Court's jurisdiction is invoked under 28 U.S.C. §1254(1).

QUESTIONS PRESENTED

1. Should the Supreme Court exercise its supervisory jurisdiction to resolve the conflict among courts of appeals, in order to prevent the dissipation of reliance on the federal courts as a forum for adjudicating the protection of proprietary technology?

2. Is the statutory presumption of validity abrogated by a judicial fiat that shifts the burden of proof to the patentee by requiring him to affirmatively prove that the patent is valid?

3. Has the Seventh Circuit Court of Appeals requirement that a patent examiner

cite all prior art to preserve the presumption of validity resulted in such an encumbrance upon the patent process as to de facto overrule 35 U.S.C. 282?

4. Did the court by granting Summary Judgment misapply F.R.C.P. rule 56 by resolving factual conflicts rather than determining whether any genuine issue of material fact existed?

STATEMENT OF THE CASE

This suit involves a 1962 patent which covers Velcro[®] target games, including a missile, such as a dart or ball, and a target board having a face against which the missile is directed. One of the elements (i. e. the missile or the target face) is provided with a textile material having outwardly extended

stiff hooks and spines, while the other element is provided with a pile fabric having upstanding loops. This material is known as Velcro.[®] Contact of the missile with the target face causes the hooks of one element to engage the loops of the other, whereby the missile adheres to the target. This device has enjoyed great commercial success in that it is presently the only target game which is safe for children.

In 1975 Centsable Products, Inc. filed a suit in the United States District Court for the Northern District of Illinois, seeking a declaratory judgment that the patent of the petitioner was invalid under Section 103 of Title 35 (obviousness). The district court found the patent invalid on a pre-trial motion for summary judgment. The district court completely dismissed the presumption

of validity as required by 35 U.S.C. 282,^{1/} on the basis that two patents disclosing the use of a natural cocklebur on a projectile were not "cited" by the examiner in prosecution. The district court felt that Velcro®

^{1/} "Further, while there does exist a presumption of validity which makes summary relief all the more elusive....

"There is no presumption of patent validity when the pertinent prior art was not before the patent examiner. Namirowski, 421 F.Supp. at 352. An examination of the Lemelson patent shows that neither the Chaffin nor the Krusi patents were cited in the Lemelson application. Accordingly, no presumption of patent validity exists for the Lemelson patent." (emphasis added) Centsable Products, Inc. v. Jerome H. Lemelson, Cadaco, Inc., Synergistics Research Corp., and Int'l Manufacturing and Marketing Corp. Unreported opinion in the U.S.D.C. for the N.D. of Ill., E.D., Appendix A, page 24a.

"As the district court found, the most important prior art was not before the patent examiner, so that there is no presumption of validity as to the Lemelson patent." (emphasis added) Centsable Products Inc. v. Jerome H. Lemelson, 591 F.2d 400 (7th Cir. 1979).

was merely a substitution for a cocklebur, despite the fact that the examiner granted invention after reviewing the Mestral (U.S. Patent No. 2,717,437) Velcro[®] - patent and a dart game. The expert examiner felt that Velcro[®] and target games were not sufficient, in his opinion, to bar invention by the application of the obviousness standard. The district court's conclusion was the direct result of the Seventh Circuit's rule that a failure to "cite" art asserted against a patent creates a presumption that the examiner overlooked the art. This "overlooked presumption" has been held in the Seventh Circuit to dissipate the statutory presumption of validity. The Court of Appeals for the Seventh Circuit affirmed the decision of the district court. Rehearing was denied March 19, 1979.

CONSTITUTIONAL AND STATUTORY
PROVISIONS INVOLVED

Constitution of the United States

Article I, §8, cl. 8:

"The Congress shall have power...to promote the Progress of Science and Useful Art, by securing for limited Times to ... Inventors the exclusive right to their 'Discoveries.'"

Statutes

35 U.S.C. §101:

"Whoever invents or discovers any new and useful ... manufacture ... or any new improvement thereof, may obtain a patent therefor."

35 U.S.C. §103:

"A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

35 U.S.C. §282:

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

REASONS FOR GRANTING THE WRIT

I. THE CONFUSED AND CONTRADICTORY STATE OF THE LAW AMONG COURTS OF APPEALS REGARDING THE PRESUMPTION OF VALIDITY AFFORDED BY 35 U.S.C. 282 HAS UNDERMINED RELIANCE UPON THE UNITED STATES PATENT SYSTEM.

A. Courts of Appeals are in conflict over the effect of "non-cited" art used to destroy the presumption of validity.

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." 35 U.S.C. §282.

"This presumption is based upon the acknowledged experience and expertise of the patent office personnel, and recognition that patent approval is a species of administrative determination supported by evidence." Parker v. Motorola, Inc., 524 F.2d 518, 521 (5th Cir. 1975), cert. denied, 425 U.S. 975.

It was firmly established case law that if art asserted against the validity of a patent was "not considered" by the patent examiner, the presumption of validity was dissipated.^{2/} The problem presently before the Court arose when the various courts of appeals interpreted what is meant by "not considered".

The theme of "considered art" has frequently been presented in patent suits over the years.^{3/} 43.4% of all patents declared

^{2/} In *Solder Removal Co. v. United States Int'l Trade Comm'n*, 582 F.2d 628 (C.C.P.A. 1978), the Court of Customs and Patent Appeals recently held it disagrees with this rule of dissipation.

"The better view, however, is that the presumption of validity is never 'destroyed' in the sense that the burden of presumption is no longer on the party asserting invalidity."

^{3/} *Laser Alignment, Inc. v. Woodruff & Sons, Inc.*, 491 F.2d 866, cert. denied 419 U.S. 874

3/ (continued)

(C.A. Ind. 1974); Henry Mfg. Co., Inc. v. Commercial Filters Corp., 489 F.2d 1008 (C.A. Ind. 1972); Reese v. Elkhart Welding & Boiler Works, Inc., 447 F.2d 517 (C.A. Ind. 1971); Williams v. V.R. Myers Pump & Supply, Inc., 371 F.2d 192 (C.A. Ind. 1966); Piel Mfg. Co. v. George A. Rolfes Co., 363 F.2d 57 (C.A. Iowa 1966); Blohm and Voss AG v. Prudential-Grace Lines, Inc., 489 F.2d 231, cert. denied 95 S.Ct. 70 (C.A. Md. 1973); Dunlop Co., Ltd. v. Kelsey-Hayes Co., 484 F.2d 407, cert. denied 94 S.Ct. 1414, two cases, 415 U.S. 917, 39 L.Ed.2d 471 (C.A. Mich. 1973); Shatterproof Glass Corp. v. Guardian Glass Co., 462 F.2d 1115, cert. denied 409 U.S. 1039 (C.A. Mich. 1972); Tapco Products Co. v. Van Mark Products Corp., 446 F.2d 420, cert. denied V.M.P. Corp. v. T.P. Co., 404 U.S. 986, appeal after remand 466 F.2d 109 (C.A. Mich. 1971); Kaiser Industries Corp. v. McLouth Steel Corp., 400 F.2d 36, cert. denied 393 U.S. 1119 (C.A. Mich. 1968); Woodstream Corp. v. Herter's, Inc., 446 F.2d 1143 (C.A. Minn. 1971); Zero Mfg. Co. v. Miss. Milk Producers Ass'n, 358 F.2d 853, cert. denied 87 S.Ct. 93, 385 U.S. 841, 17 L.Ed.2d 74 (C.A. Miss. 1966); Ralston Purina Co. v. General Foods Corp., 442 F.2d 389 (C.A. Mo. 1971); Philips Electronic & Pharmaceutical Industries Corp. v. Thermal & Electronics Industries, Inc., 450 F.2d 1164 (C.A.N.J. 1971); Ling-Temco-Vought, Inc. v. Kollsman Instrument Corp., 372 F.2d 263 (C.A.N.Y. 1967);

3/ (continued)

Westwood Chemical, Inc. v. Owens-Corning Fiberglas Corp., 445 F.2d 911, cert. denied 405 U.S. 917 (C.A. Ohio 1971); B.F. Goodrich Co. v. Rubber Latex Products, Inc., 400 F.2d 401 (C.A. Ohio 1968); U.S. Expansion Bolt Co. v. Jordan Industries, Inc., 488 F.2d 566 (C.A. Pa. 1973); Hadco Products, Inc. v. Walter Kidde & Co., 462 F.2d 1265, cert. denied 409 U.S. 1023 (C.A. Pa. 1972); Blumcraft of Pittsburgh v. Citizens and Southern Nat. Bank of S.C., 407 F.2d 557, cert. denied 395 U.S. 961, reh. denied 396 U.S. 870, reh. denied 396 U.S. 949 (C.A. S.C. 1969); Bolkcom v. Carborundum Co., 523 F.2d 492, cert. denied 425 U.S. 951 (C.A. Tenn. 1975); Schnadig Corp. v. Gaines Mfg. Co., Inc., 494 F.2d 383 (C.A. Tenn. 1974); Gaddis v. Calgon Corp., 506 F.2d 880 (C.A. Tex. 1975); Williamson-Dickie Mfg. Co. v. Hortex Inc., 504 F.2d 983 (C.A. Tex. 1974); Ag Pro, Inc. v. Sakraida, 474 F.2d 167, supplemented 481 F.2d 668, appeal after remand 512 F.2d 141, cert. granted 423 U.S. 891, reversed 425 U.S. 273, reh. denied 426 U.S. 955, on remand 536 F.2d 110 (C.A. Tex. 1973); Metal Arts Co. v. Fuller Co., 389 F.2d 319 (C.A. Tex. 1968); Christopher J. Foster, Inc. v. Newport News Shipbuilding & Dry Dock Co., 531 F.2d 1243 (C.A. Va. 1975); Research Corp. v. NASCO Industries, Inc., 501 F.2d 358, cert. denied 419 U.S. 1096 (C.A. Wis. 1974); Leach v. Rockwood & Co., 404 F.2d 652 (C.A. Wis. 1968); National Dairy Products Corp. v. Borden Co., 394 F.2d

3/ (continued)

887, cert. denied 393 U.S. 953 (C.A. Wis. 1968); T. P. Laboratories, Inc. v. Huge, 371 F.2d 231 (C.A. Wis. 1966); Roberts Dairy Co. v. U.S., 530 F.2d 1342 (Ct.Cl. 1976); Nossen v. U.S., 416 F.2d 1362, 189 Ct.Cl. 1, reh. denied 422 F.2d 1340, 191 Ct.Cl. 198, cert. denied 91 S.Ct. 44, 400 U.S. 823, 27 L.Ed. 2d 51 (Ct.Cl. 1969); International Glass Co. v. U.S., 408 F.2d 395, 187 Ct.Cl. 376 (Ct.Cl. 1969); Ellicott Mach. Corp. v. U.S., 405 F.2d 1385, 186 Ct.Cl. 655 (Ct.Cl. 1969); Soundsciber Corp. v. U.S., 360 F.2d 954, 175 Ct.Cl. 644 (Ct.Cl. 1966); Martin-Marietta Corp. v. U.S., 373 F.2d 972, 179 Ct.Cl. 70 (Ct.Cl. 1967); Soundsciber Corp. v. U.S., 360 F.2d 954, 175 Ct.Cl. 644 (Ct.Cl. 1966); Arthur J. Schmitt Foundation v. Stockham Valves & Fittings, Inc., 292 F.Supp. 893, affirmed Stockham Valves & Fittings, Inc. v. Arthur J. Schmitt Foundation, 404 F.2d 13, reh. denied 420 F.2d 699, cert. denied 398 U.S. 965 (D.C. Ala. 1968); Saf-Gard Products, Inc. v. Service Parts, Inc., 370 F. Supp. 257 (D.C. Ariz. 1974); Maurice A. Garbell, Inc. v. Boeing Co., 385 F.Supp. 1, affirmed 546 F.2d 297, cert. denied 97 S.Ct. 2677 (D.C. Cal. 1974); Farmer Bros Co. v. Coca-Cola Co., 384 F.Supp. 595 (D.C. Cal. 1974); Esso Research & Engineering Co. v. Kahn & Co., Inc., 379 F.Supp. 205, affd. 513 F.2d 1341 (D.C. Conn. 1974); Azoplate Corp. v. Silverlith, Inc., 367 F.Supp. 711, affd. 506 F.2d 1050, cert. denied 421 U.S. 914 (D.C. Del. 1973); Noma Lites Canada,

3/ (continued)

Ltd. v. Westinghouse Elec. Corp., 399 F. Supp. 243 (D.C.D.C. 1975); Filmon Process Corp. v. Spellright Corp., 274 F.Supp. 312, affd. 404 F.2d 1351, 131 U.S.App.D.C. 374 (D.C.D.C. 1967); Compagnie De Saint-Gobain v. Commissioner of Patents, 251 F.Supp. 439, affd. 386 F.2d 985, 128 U.S.App.D.C. 223 (D.C.D.C. 1966); Hart v. Baarcke, 396 F.Supp. 408, affd. 550 F.2d 353 (D.C.Fla. 1975); Harrington Mfg. Co. v. White, 323 F.Supp. 1345, rev'd 475 F.2d 788, reh. denied, 478 F.2d 1402, cert. denied 414 U.S. 1040 (D.C. Fla. 1971); High Voltage Engineering Corp. v. Boise Cascade Corp., 310 F. Supp. 395 (D.C. Idaho 1970); St. Regis Paper Co. v. Bemis Co., Inc., 403 F.Supp. 776, rev'd 549 F.2d 833 (D.C. Ill. 1975); Ropat Corp. v. McGraw-Edison Co., 393 F.Supp. 1108, affd. 535 F.2d 378 (D.C. Ill. 1975); Vollrath Co. v. Premium Plastics, Inc., 385 F.Supp. 843 (D.C. Ill. 1974); Ropat Corp. v. West Bend Co., 382 F.Supp. 1030 (D.C. Ill. 1974); Crane Co. v. Aeroquip Corp., 364 F.Supp. 547, affd. in pt., rev'd in pt. 504 F.2d 1086 (D.C. Ill. 1973); All States Plastic Mfg. Co., Inc. v. Weckesser Co., Inc., 362 F.Supp. 94 (D.C. Ill. 1973); Popeil Bros., Inc. v. Schick Elec., Inc., 356 F.Supp. 240, affd. 494 F.2d 162 (D.C. Ill. 1972); King-Seeley Thermos Co. v. Reynolds Products, Inc., 322 F.Supp. 713 (D.C. Ill. 1970); Shelco, Inc. v. Dow Chemical Co., 322 F.Supp. 485, affd. 466 F.2d 613, cert. denied 409 U.S. 876 (D.C. Ill. 1970); Bela Seating Co. v.

3/ (continued)

Poloron Products, Inc., 297 F.Supp. 489, affd. 438 F.2d 733, cert. denied 403 U.S. 922 (D.C. Ill. 1968); Ransburg Electro-Coating Corp. v. Nordson Corp., 293 F.Supp. 448 (D.C. Ill. 1968); Ill. Tool Works, Inc. v. Continental Can Co., 273 F.Supp. 94, affd. 397 F.2d 517 (D.C. Ill. 1967); Endevco Corp. v. Chicago Dynamic Industries, Inc., 268 F.Supp. 640 (D.C. Ill. 1967); Technicon Instruments Corp. v. Coleman Instruments, Inc., 255 F.Supp. 630, affd. 385 F.2d 391 (D.C. Ill. 1966); Koehring Co. v. E. D. Etnyre & Co., 254 F.Supp. 334 (D.C. Ill. 1966); Howe v. General Motors Corp., 252 F.Supp. 924 (D.C. Ill. 1966); Jenkins v. Elligan, 253 F.Supp. 403 (D.C. Ill. 1965); Henry Mfg. Co., Inc. v. Commercial Filters Corp., 350 F.Supp. 1015, affd. 489 F.2d 1008 (D.C. Ind. 1972); Mercantile Nat. Bank of Chicago v. Quest, Inc., 303 F.Supp. 926 (D.C. Ind. 1969); Proctor-Silex Corp. v. Arvin Industries, Inc., 301 F.Supp. 1308 (D.C. Ind. 1969); Norris Industries, Inc. v. Best Universal Lock Co., 296 F.Supp. 372 (D.C. Ind. 1968); University of Illinois Foundation v. Winegard Co., 271 F.Supp. 412, affd. 402 F.2d 125, cert. denied 394 U.S. 917, reh. denied 91 S.Ct. 1641, 402 U.S. 990, 29 L.Ed.2d 157 (D.C. Iowa 1967); Greening Nursery Co. v. J & R Tool & Mfg. Co., 252 F.Supp. 117, affd. 376 F.2d 738 (D.C. Iowa 1966); Ellicott Mach. Corp. v. Wiley Mfg. Co., 297 F.Supp. 1044 (D.C. Md. 1969); Panduit Corp. v. Stahlin Bros. Fibre Works.

3/ (continued)

Inc., 298 F.Supp. 435, affd. 430 F.2d 221, cert. denied 401 U.S. 939 (D.C. Mich. 1969); Rehrig Controls Co. v. Maxitrol Co., 253 F.Supp. 896 (D.C. Mich. 1966); Antici v. KBH Corp., 324 F.Supp. 236, affd. 455 F.2d 607 (D.C. Miss. 1971); Rubbermaid Inc. v. Contico Int'l., Inc., 381 F.Supp. 666 (D.C. Mo. 1974); Rubbermaid Inc. v. Contico Int'l., Inc., 371 F.Supp. 678 (D.C. Mo. 1974); Ralston Purina Co. v. General Foods Corp., 375 F.Supp. 1023, affd. 442 F.2d 389 (D.C. Mo. 1969); Anchor Plastics Co., Inc. v. Dynex Indus. Plastics Corp., 363 F.Supp. 582, affd. 492 F.2d 1238, cert. denied 417 U.S. 955 (D.C.N.J. 1973); Novelart Mfg. Co. v. Carlin Container Corp., 363 F.Supp. 58 (D.C.N.J. 1973); Worthington v. Southern New Jersey Newspapers, Inc., 323 F.Supp. 443 (D.C.N.J. 1970); Phillips Electronic & Pharmaceutical Industries Corp. v. Thermal & Electronics Industries, Inc., 311 F.Supp. 17, affd. 450 F.2d 1164 (D.C.N.J. 1970); Atlas Copco Aktiebolag v. Ingersoll-Rand Co., 279 F.Supp. 783 (D.C.N.J. 1967); Engelhard Industries, Inc. v. Sel-Rex Corp., 253 F.Supp. 832, opinion supplemented 255 F.Supp. 620, affd. 384 F.2d 877 (D.C.N.J. 1966); U.S. Philips Corp. v. National Micronetics Inc., 410 F.Supp. 449, affd. 550 F.2d 716 (D.C.N.Y. 1976); Mr. Hanger, Inc. v. Cut Rate Plastic Hangers, Inc., 372 F.Supp. 88 (D.C.N.Y. 1974); Kahn v. Dynamics Corp. of America, 367 F.Supp. 63, cause remanded 508 F.2d 939; cert. denied 421 U.S. 930

3/ (continued)

(D.C.N.Y. 1973); Mock Fashioning Associates v. Manhattan Shirt Co., 276 F.Supp. 363 (D.C.N.Y. 1967); C-Thru Products, Inc. v. Uniflex, Inc., 262 F.Supp. 213, affd. 397 F.2d 952 (D.C.N.Y. 1966); Long Mfg. Co. v. Lilliston Implement Co., 328 F.Supp. 268, affd. 457 F.2d 1317, cert. denied 409 U.S. 874 (D.C.N.C. 1971); Karr v. Botkins Grain & Feed Co., 329 F.Supp. 411 (D.C. Ohio 1970); Frohock-Stewart, Inc. v. Reed-Cromex Corp., 254 F.Supp. 120 (D.C. Ohio 1966); Aluminum Co. of America v. Amerola Products Corp., 408 F.Supp. 1352, affd. 552 F.2d 1020 (D.C. Pa. 1976); Chisholm-Ryder Co., Inc. v. Lewis Mfg. Co., Inc., 398 F.Supp. 1287, affd. 547 F.2d 1159 (D.C. Pa. 1975); Metallurgical Exoproducts Corp. v. Pittsburgh Metals Purifying Co., Inc., 393 F.Supp. 1104, affd. 532 F.2d 747, cert. denied 429 U.S. 829 (D.C. Pa. 1975); Allegheny Drop Forge Co. v. Portec, Inc., 370 F.Supp. 673, affd. 541 F.2d 383 (D.C. Pa. 1974); Fischer & Porter Co. v. Haskett, 354 F.Supp. 464 (D.C. Pa. 1973); U.S. Expansion Bolt Co. v. Jordan Industries, Inc., 346 F.Supp. 541, affd. 488 F.2d 566 (D.C. Pa. 1972); Roller Bearing Co. of America v. Bearings, Inc., 328 F.Supp. 923 (D.C. Pa. 1971); Allen Bradley Co. v. Air Reduction Co., 273 F.Supp. 930, affd. 391 F.2d 282 (D.C. Pa. 1967); Maschinenfabrik Rieter, A. G. v. Greenwood Mills, 340 F.Supp. 1103 (D.C. S.C. 1972); Sabel v. Wickes Corp., 345 F.Supp. 1227 (D.C.S.C. 1971); Carter v.

invalid from 1952 to 1977 were the result of the assertion of non-considered art.^{4/} An

^{3/} (continued)

Rice, 398 F.Supp. 474 (D.C. Tex. 1975); Banning v. Southwestern Bell Tel. Co., 384 F.Supp. 831 (D.C. Tex. 1974); Barnard v. Fruehauf Trailer Co., 260 F.Supp. 605 (D.C. Tex. 1966); Cyclo Floor Mach. Corp. v. National Housewares, Inc., 296 F.Supp. 665 (D.C. Utah 1968); Grinnell Corp. v. Virginia Elec. & Power Co., 277 F.Supp. 507, affd., 401 F.2d 451 (D.C. Va. 1967); Eversharp, Inc. v. Philip Morris, Inc., 256 F.Supp. 778, affd., 374 F.2d 511 (D.C. Va. 1966); Frantz Mfg. Co. v. Phenix Mfg. Co., 307 F.Supp. 822, motion denied 314 F.Supp. 99, affd. in pt., revd. in pt., 457 F.2d 314 (D.C. Wis. 1970); Oglebay Norton Co. v. Universal Refractories Corp., 300 F.Supp. 1106 (D.C. Wis. 1969); Baker Mfg. Co. v. Whitewater Mfg. Co., 298 F.Supp. 1389, revd. 430 F.2d 1008, cert. denied 401 U.S. 956 (D.C. Wis. 1969); National Dairy Products Corp. v. Borden Co., 261 F.Supp. 771, revd. 394 F.2d 887, cert. denied 393 U.S. 953 (D.C. Wis. 1966); Consolidated Kinetics Corp. v. Marshall, Neil & Pauley, Inc., 521 P.2d 1209, 11 Wash.App. 173 (Wash.App. 1974); Randuit Corp. v. Burndy Corp., 517 F.2d 535, cert. denied 423 U.S. 987 (C.A. Ill. 1975).

^{4/} David A. Lowin, The Presumption of Validity: A Study of Its Effect on Case Law

early statement of the law was expressed in
Detroit Motor Appliance Co. v. Burke.

"It is contended that the patent office did not have before it the prior art disclosed by the above mentioned patents, except Brock and Lanchester. It is true that these two patents are the only citations in the file wrapper; but this is far from proving that the other patents were not considered. The presumption is that the officials of the Patent Office did their duty, and considered the other patents now brought forward as new prior art." (emphasis added) Detroit Motor Appliance Co. v. Burke, 4 F.2d 118, 122 (8th Cir. 1925).

The Seventh Circuit followed the rule of Detroit Motor Appliance Co. v. Burke in Adler Sign Letter Co. v. Wagner Sign Service, 112 F.2d 264, 267 (7th Cir. 1940),

4/ (continued)

Since 1952, an Academy of Applied Sciences research project conducted by the Entrepreneurial Workshop of the Franklin Pierce Law Center (P.T.C. Research Foundation of the Franklin Pierce Law Center, Concord, New Hampshire, 1979).

cert. denied 311 U.S. 692

"The Bindhamer and Francis patents were cited in the Patent Office but not those of Send and Standfish. It is argued by Adler that it follows these two patents were overlooked by the Patent Office and, if the Patent Office had considered them, a different result would have been reached. We do not think it necessarily follows, however, merely from the fact that they were not cited, that they were overlooked. It is just as reasonable to conclude that they were considered and cast aside as not pertinent."

The Seventh Circuit followed this rule for over twenty years. In Artmoore Co. v. Dayless Mfg. Co., Inc., 208 F.2d 1 (7th Cir. 1953), cert. denied 347 U.S. 920, the court held

"Defendant's argument based on these prior art patents, not cited in the Patent Office is not convincing. It has been held, and we think with logic, that it is [as] reasonable to conclude that [an uncited] prior art patent ... was considered and cast aside because not pertinent, as to conclude that it was inadvertently overlooked."

The first move away from the "cast aside rule" was seen in A R Inc. v. Electro-Voice, Inc., 311 F.2d 508, 513 (7th Cir. 1962). The court held that the unconsidered prior art read directly on the patent in suit and then stated,

"... there can be no presumption that the examiner reviewed and discarded it [the prior art] it is more likely he missed it."

This movement away from the "cast aside" or "presumed discarded" rule was in two forms. First, the court did not require any standard of proof to support the presumption of validity. It "presumed" quite to the contrary that the examiner had not done his job and in an arbitrary and uncontrolled manner dismissed this statutory requirement. Second, the court laid the foundation for the new requirement of "citing" every patent looked at in order to

assure that the Patent and Trademark Office "considered the art".

In Gettelman Mfg., Inc. v. Lawn 'N' Sport Power Mower Sales & Service, Inc., 517 F.2d 1194 (7th Cir. 1975), the Seventh Circuit Court took advantage of the groundwork formulated in Electro-Voice and formally established the new "citing" requirement, when the asserted art is in a class not searched or when the asserted art is "the best art".

"[I]f a prior art patent is not cited but its class is searched then it is presumed that the examiner considered and discarded it as being no more relevant than the other prior art."

However, under those particular facts albeit the Ritchie patent was in the art classification searched it was found to be the "best prior art" and the presumption did not

apply.

This movement away from the "cast aside" or "presumed discarded" rule was substantial. The court first of all created a distinction between those subclasses of the art searched and not searched. Secondly, and more significantly, the court affirmed that it has an unlimited power to look at all the art asserted and to rule, as a non-expert with the advantage of hindsight, which is the best art. Thus, the Congressional intent of bestowing deference to Patent Office administrative and technical expertise^{5/} was affirmatively removed.

This new requirement "to cite" was

^{5/} Federico's Commentary, 35 U.S.C.A. 1954; Parker v. Motorola, Inc., 153 U.S. 1201, 524 F.2d 578; Artmoore Co. v. Dayless Mfg. Co., Inc., 208 F.2d 1 (7th Cir. 1953), cert. denied 347 U.S. 920.

reaffirmed by the Seventh Circuit Court of Appeals in Chicago Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452 (7th Cir. 1975), cert. denied 423 U.S. 1091, when it cited Gettelman and said:

"Nor may we surely assume that the examiner has considered art which was not cited. On the contrary, we have held that the failure to cite pertinent art implies that it was overlooked by the examiner."

The critical distinction relating to whether the art was searched was not at issue and therefore not mentioned in Chicago Rawhide. The prior Gettelman holding, based upon facts unique to that case, was broadly expanded to encompass a general rule of law in the Seventh Circuit.

In National Cash Register v. Eastman Kodak, 191 U.S.P.Q. 1941 (7th Cir. 1976), the dicta from Chicago Rawhide was used to

specifically overrule the "discarded" or "cast aside" line of cases and to close the door on the presumption of validity in the Seventh Circuit.

This law is so firmly ingrained in the Seventh Circuit that when petitioner (a man who is not unfamiliar with patent law as he has prosecuted over 250 patent applications pro se and had over 300 patents issued in his name) requested his legal counsel to inform the court that the Krusi and Chaffin^{6/} patents asserted against his patent were in the art class and subclass searched by the examiner, counsel refused and justified his refusal outlining the law in the Seventh Circuit on point.^{7/}

^{6/} M. B. Krusi, U.S. Patent No. 1,538,640
W. B. Chaffin, U.S. Patent No. 740,397

^{7/} Letter of October 2, 1978 from Victor Wigman of Wigman and Cohen, Crystal Place 1, 2001 Jefferson Davis Highway, Arlington, Va. 22202.

This requirement to "cite" every patent looked at by the Patent and Trademark Office is not universal throughout the United States. The following outline represents the respective positions of each circuit considering the issue:

Circuits Requiring Prior Art Patent
To Be "Cited" By The Examiner
In Order To Invoke 35 U.S.C. 282

Second Circuit

"Finally, the failure of the Patent Office to actually cite patents that comprise, in part, the prior art further undercuts the weight of the presumption." Lemelson v. Topper Corp., 450 F.2d 845 (2d Cir. 1971)

Fourth Circuit

"The prima facie presumption of the patent's validity (35 U.S.C. §282) can be given little weight. The Patent Office cited none of the ornamental railings found in the prior art." Blumcraft of Pittsburgh v. Citizens and Southern Nat. Bank of S.C., 407 F.2d 557, 561 (4th Cir. 1969), cert. denied 395 U.S. 961, rehearing denied 396 U.S. 949, 396 U.S. 870.

Seventh Circuit

"NCR argues that because the patent examiner stated that he diligently searched the prior art, it must nevertheless be assumed that he considered the patents offered by defendant, especially Pratt and Wally, which are in the same class and sub-class as Akiyama. While this may once have been the rule in this Circuit [cites omitted], it is no longer so."

National Cash Register Corp. v. Eastman Kodak Co., 191 U.S.P.Q. 194 (7th Cir. 1976)

"Nor may we safely assume that the Examiner has considered art which is not cited. On the contrary, we have held that the failure to cite pertinent prior art implies that it was overlooked by the Examiner."

Chicago Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452 (7th Cir. 1975), cert. denied 423 U.S. 1091.

Circuits Which Do Not Require The Citing Of Prior Art Patents In Order To Maintain The Statutory Presumption Of Validity

Fifth Circuit

"The fact that prior relevant patents were not specifically cited by the patent office did not alone warrant the conclusion that patent examiner did not in fact, consider them or

cast them aside as less pertinent than those cited." Hobbs v. Atomic Energy Commission, 451 F.2d 849 (5th Cir. 1971)

Sixth Circuit

"Alleged art that is cumulative to cited art does not weaken or destroy the presumption of validity." Schnadig Corp. v. Gaines Mfg. Co., Inc., 494 F.2d 383, 391 (6th Cir. 1974)

Eighth Circuit

"Notwithstanding Mr. Justice Clark's admonition in Graham supra, that '[h]e who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office,' the plaintiff succeeds here, primarily, because the defendants have failed to rebut the §282 presumption (35 U.S.C. §282) attaching to the Conibar patent. Contrary to the contention of the appellees, this presumption of validity has not been weakened or destroyed in this case merely because the defendants cite Ullman as a pertinent reference not cited as relevant art in the United States Patent Office documents.... Thus, the failure of the Patent Office to cite Ullman does not erode the strength of the presumption." Woodstream Corp. v. Herter's Inc.,

446 F.2d 1143 (8th Cir. 1971)

Ninth Circuit

"Since the patent office considered items which were representative of the prior state of learning and which were more pertinent than one allegedly omitted, the failure to consider Karmazin does not destroy the presumption that the patent office made a proper determination." Saf-Gard Products, Inc. v. Service Parts, Inc., 532 F.2d 1266 (9th Cir. 1976), cert. denied 429 U.S. 896.

Court of Appeals District of Columbia

"As to the issue of obviousness under §103, we have reiterated time and again that a presumption of validity accompanies the action of the Patent Office, and that a court should not interfere with the action 'in the absence of new evidence carrying 'thorough conviction'" that had not been considered by the Patent Office." Hays v. Brenner, 357 F.2d 287 (C.A.D.C. 1966)

United States Court of Customs
and Patent Appeals

"We are not unaware of language in some court opinions indicating that no presumption exists when prior art not considered by the PTO is

cited to the court [cites omitted]. The better view, however, for the reasons stated above, is that the presumption of validity is never 'destroyed' in the sense that the burden of persuasion is no longer upon the party asserting invalidity. " Solder Removal Co. v. United States Int'l Trade, 582 F.2d 628, 632-33 (C.C.P.A. 1978)

B. Courts Of Appeals Are In Conflict And Complete Disarray Over What Standard Of Proof Is Required To Rebut The Presumption Of Validity

The standards of proof required to rebut the presumption of validity as required by the Court of Appeals include most known evidentiary standards. The following is illustrative of the confused and contradictory state of the law in this area.

"The courts, however, have not distinguished themselves for consistency in their determination of the quantum of proof necessary to rebut the presumption. For instance, this court has employed varying statements of the necessary quantum of proof. See, e.g. Kardulas v. Florida Machine Products Co., 5 Cir. 1971, 438 F.2d

1118 ('clear and convincing *** a mere preponderance of the evidence is insufficient *** beyond the reasonable doubt'); V & S Ice Machine Co. v. Eastex Poultry Co., 5 Cir. 1971, 437 F.2d 422 ('competent evidence'); Stamicarbon, N. V. v. Escambia Chemical Corp., 5 Cir. 1970, 430 F.2d 920 (reviewing all the standards); Kiva Corp. v. Baker Oil Tools, 5 Cir. 1969, 412 F.2d 546 ('beyond a reasonable doubt *** clear and convincing'); Metal Arts Co. v. Fuller Co., 5 Cir. 1968, 389 F.2d 319 ('clear, satisfactory, and by some it is said beyond a reasonable doubt'); Zero Mfg. Co. v. Mississippi Milk Producers Assoc., 5 Cir. 1966, 358 F.2d 853 ('strong rebuttal'); Southern Implement Mfg. Co. v. McLemore, 5 Cir. 1965, 350 F.2d 244 ('beyond a reasonable doubt'); Samuelson v. Bethlehem Steel Co., 5 Cir. 1963, 323 F.2d 944 ('Any reasonable doubt will be resolved against the party alleging the invalidity of a patent'); Fairchild v. Poe, 5 Cir. 1958, 259 F.2d 329 ('beyond a reasonable doubt'); Zachos v. Sherwin-Williams Co., 5 Cir. 1949, 177 F.2d 762 ('beyond a reasonable doubt'). We do not attempt to resolve this apparent inconsistency. Rather, we state that the presumption of patent validity may be rebutted only by a quantum of proof-whether it be called clear and convincing or beyond a reasonable doubt-which is

greater than a mere preponderance of the evidence." Hobbs v. Atomic Energy Commission, 451 F.2d 849, 856 (5th Cir. 1971).

The following circuit by circuit analysis highlights the use of differing standards:

First Circuit

"The presumption of validity having been weakened, it follows that while a burden still remained on the challenger it would, as a practical matter be less than the burden embodied in the clear and convincing standard." (emphasis added) Futorian Mfg. Corp. v. Dual Mfg. & Engineering, Inc., 528 F.2d 941 (1st Cir. 1976)

Second Circuit

"Reasonable doubt on the issue of validity must be resolved in favor of the patent holder, but in the usual case a preponderance of the evidence determines the issue." (emphasis added) John K. Rains v. Niaqua Inc., 406 F.2d 275 (2d Cir. 1969)

Third Circuit

"Indeed, invalidity must be demonstrated by clear and convincing proof." (emphasis added) Ever-Wear Inc. v. Weiboldt Stores, Inc., 427 F.2d 373

(7th Cir. 1970); Trio Process Corp. v. L. Goldstein's Sons, Inc., 461 F.2d 66 (3d Cir. 1972), cert. denied 409 U.S. 997

Fourth Circuit

"The evidence is greater than a mere preponderance and squarely rebuts the presumption of patent validity accorded by 35 U.S.C. §282." (emphasis added) Diamond International Corp. v. Maryland Fresh Eggs, Inc., 523 F.2d 113 (4th Cir. 1975)

Fifth Circuit

"One otherwise an infringer who assails the validity of a regularly issued patent bears a heavy burden of persuasion. We have variously recognized this burden to be akin to the fraud standard of clear and convincing evidence and to the criminal law standard of proof beyond a reasonable doubt, but, at a minimum, greater than a mere preponderance of the evidence." (emphasis added) Ingersoll-Rand Co. v. Brunner & Lay, Inc., 474 F.2d 491 (5th Cir. 1973), cert. denied 414 U.S. 865

Sixth Circuit

"We do not commit this Circuit to any general rule requiring the application of this standard in all patent cases." (emphasis added) Dickstein v. Seventy Corp., 522 F.2d 1294 (6th Cir. 1975, cert. denied 423 U.S. 1055

Seventh Circuit

"Presumption of patent validity never imposes a heavier burden than that of making a clear and convincing showing of invalidity." (emphasis added) Chicago Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452 (7th Cir. 1975), cert. denied 423 U.S. 1091

Eighth Circuit

"Presumption rebutted and may be overcome by substantial evidence negating anyone of the three essentials for patentability." (emphasis added) L. & A. Products, Inc. v. Britt Tech Corp., 223 F. Supp. 126 (8th Cir. 1966)

Ninth Circuit

"Clear and convincing evidence." (emphasis added) Saf-Gard Products,

Inc. v. Service Parts, Inc., 532 F.2d
1266 (9th Cir. 1976), cert. denied
429 U.S. 896

Tenth Circuit

"Clear and convincing evidence."
(emphasis added) Moore v. Shultz,
491 F.2d 294 (10th Cir. 1974), cert.
denied 419 U.S. 930

Conflicting rulings of this sort are tantamount to the federal courts creating a federal system of regional common law, which has long been prohibited by Erie v. Tompkins.^{8/} Such discord among the Courts of Appeals has made forum shopping a clear reality in patent litigations, a situation in disfavor with this Court as pointed out in Blonder-Tongue.^{9/}

The conflicts at hand, however, strike

^{8/} Erie R.R. v. Tompkins, 304 U.S. 64 (1938)

^{9/} Blonder-Tongue Laboratories, Inc. v. University of Ill. Foundation, 402 U.S. 313 (1971)

at the heart of an issue that is even more important than the creation of federal common law or forum shopping, an issue recognized as a major link to the economic strength of this nation. In a recent draft report to the Secretary of Commerce it was pointed out:

"The United States has been the leading innovative nation in modern times and has created many new industries. One need only look at the major new industries started within the last 50 years, such as those involving electronics, laser, antibiotics, synthetic fibers, instant photography and xerography. There is still room for further innovation and it will continue if provided with a proper environment. Such an environment existed for years and produced outstanding results. Our patent system contributed significantly to an environment which promotes innovation. Unfortunately, there have been disturbing recent indications that there has been a decrease in the rate of innovation and that portion of the R&D investment devoted to new product lines and basic research. (emphasis added)

"One of the ways to encourage investment to complete the innovation process

by commercializing inventions is by reducing the risks involved in decisions to commercialize. The risks of commercializing inventions can be reduced if the inventions are the subject of reliable patents ...^{10/}

A federal court system with a disarray of conflicting decisions regarding the presumption of validity and its evidentiary standard cannot be a forum of reliability. This Court's supervision and direction is badly needed to restore the judicial forum that once backed our innovative community.

II. THE PRESUMPTION OF VALIDITY AFFORDED BY 35 U.S.C. §282 HAS BEEN ABROGATED BY A JUDICIAL FIAT WHICH SHIFTS THE BURDEN OF PROOF TO THE PATENTEE. THE

^{10/} Draft report of the Advisory Subcommittee on Patent and Information Policy of the Advisory Committee on Industrial Innovation (established as a part of the domestic policy review, 12/20/78). Directed by the Industrial Innovation Committee, chaired by Secretary of Commerce Juanita M. Kreps.

SHIFT IN THE BURDEN OF PROOF TO THE PATENTEE HAS BEEN ACCOMPLISHED BY A CIRCUIT COURT OF APPEALS REQUIREMENT THAT THE PATENT AND TRADEMARK OFFICE CITE VIRTUALLY EVERY PRIOR PATENT IN THE ART SEARCHED. THE RESULT OF THIS REQUIREMENT IS TO PLACE THE PATENTEE IN THE POSITION OF HAVING TO PROVE THAT THE PATENT AND TRADEMARK OFFICE HAS FAITHFULLY PERFORMED ITS DUTIES. THE SUPREME COURT SHOULD EXERCISE ITS SUPERVISORY POWERS TO PREVENT THIS USURPATION OF ADMINISTRATIVE AUTHORITY AND RESTORE THE STATUTORY MANDATE.

The allocation of the burden of proof in patent cases is clearly enunciated in Title 35 of the United States Code Section 282 -

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

"The first sentence of §282 that '(a) patent shall be presumed valid' must be read in the context of the remainder of the first paragraph of §282, which provides that the party asserting invalidity bears the burden of establishing it." Solder Removal

Company v. United States Int'l Trade Commission, 582 F.2d 628 (United States Court of Customs and Patent Appeals, 1978).

Recently, the Seventh Circuit Court of Appeals has radically digressed from the presumption of validity and allocation of burden of proof contained in §282. The court has accomplished the digression indirectly by requiring that the Patent and Trademark Office cite every prior patent in the art searched. If all prior art has not been cited, the court presumes that it has been overlooked and not considered, the patent is often deemed obvious and invalid in light of the non-cited prior art (without the application of the Deere tests^{11/} of obviousness). This judicial

^{11/} Standards by which obviousness should be judged:

1. What is the scope and content of the prior art?

posture requires the patentee to affirmatively defend his patent in direct contradiction of §282.

The legislative history and the judicial development of §282 define patentees as a favored class of litigants.^{12/} The result of the comprehensive citing requirement is to shift the burden of proof of patent validity from the infringer to the ostensibly favored litigant, the patentee. It is now the patentee who must affirmatively prove the validity of

^{11/} (continued)

2. What is the difference between the prior art and the claims at issue?

3. What is the level of ordinary skill in the art?

Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966)

^{12/} Blonder-Tongue Laboratories, Inc. v. University of Ill. Foundation, 402 U.S. 313, 331, 335 (1971). "We fully accept congressional judgment to reward inventors through the patent system...patentees are heavily favored as a class of litigants by the patent statute."

his invention, or suffer infringement or invalidation. In this manner your petitioner has suffered the loss of the protection which is ordinarily afforded a newly issued patent and has had his patent unfairly attacked and declared invalid.

In Solder Removal Company v. United States Int'l Trade Commission, supra, at 628, the most authoritative court on patent law has recently addressed this issue and has met the proper resolution:

"The presumption of patent validity shifts not only the burden of going forward in a purely procedural sense but also places the burden of persuasion on the party who asserts the patent is invalid. 35 U.S.C.A. §282."

The Patent and Trademark Office had failed to cite two prior art patents

which your petitioner submits were not pertinent. The court received affidavits attesting to the non-pertinence of the uncited art and erroneously, without regard to this evidence, held the asserted art to be pertinent. The court did not make its inquiry in the favorable light of the presumption of validity as required by the statute. On rehearing, petitioner, through an expert affidavit,^{13/} pointed out that the art "cited" was at least as pertinent as the Krusi and Chaffin patents. The Court of Customs

^{13/} Appendix E, Affidavit of Leonard S. Knox,

"I am of the opinion that the Chaffin and Krusi patents are no more relevant than those patents which were cited."

and Patent Appeals in Solder Removal Company, addresses this point of law by pointing out that even if the court had properly determined the non-cited art to be more pertinent, the statutory presumption is not dissipated:

"The statutory presumption of validity exists even when the most pertinent art was neither presented to nor considered by the Patent and Trademark Office. The burden of persuasion is and remains always on the party asserting invalidity of a patent, whether or not the most pertinent prior art was considered by the examiner. 35 U.S.C.A. §282." (emphasis added) Solder Removal Co. v. United States Int'l Trade Commission, 582 F.2d 628, 632 (C.C.P.A. 1978)

Other courts have addressed the issue and described the presumption of validity and the placement of the burden of proof:

"(A) defendant in a patent infringement suit must not only introduce proof to overcome the presumption of patent validity but must also rebut whatever proof the patentee offers to bolster his claim." Woodstream Corp.

v. Herter's Inc., 446 F.2d 1143 (8th Cir. 1971)

"There is a statutory presumption that a patent is valid, and it is the challengers' carrying the burden of proof who must overcome it." Rich Products Corp. v. Mitchell Foods, Inc., 357 F.2d 176 (2d Cir. 1966)

"Every patent is presumed valid and the burden to make a good defense of invalidity is a heavy one and every reasonable doubt should be resolved against the party setting up such a defense." Arthur J. Schmitt Foundation v. Stockham Valves & Fittings, Inc., 292 F.Supp. 893 (N.D. Ala. 1966)

In light of the court's arbitrary and capricious disregard of 35 U.S.C. §282, your petitioner submits that he suffered the loss of property rights without due process of law.

Your petitioner finds no evidence in the legislative history of Title 35 U.S.C. §282 which would justify reallocation of the burden of proof. When a patent is stripped of the protection afforded by the presumption of

validity it becomes extremely vulnerable to attack by infringers. The burden of affirmatively defending a patent without the presumption of validity is compounded because it ultimately requires that the patentee supervise the activities of the Patent and Trademark Office.

The immediate supervision of this Court is required in order to restore the mandate of §282. It is §282 which provides the needed protection of inventors' property rights and encourages innovation which has, sadly, been in decline in the United States. Your petitioner submits that a direct link exists between the open disregard of §282 and the decline of innovation in the United States relative to other nations. Of late, Japan and The Federal Republic of Germany have, most notably, been outstripping United

States technology. In those nations protection of inventor's proprietary rights is more comprehensive.

In rendering its decision against your petitioner, the Seventh Circuit Court of Appeals has argued that the Patent Office is failing to adequately perform its duty and, therefore, the court was compelled to intervene by establishing a new standard that effectively removed §282. This decision, if allowed to stand, will impose an inequitable and unlawful burden upon your petitioner and similarly situated patentees. The end result can only be a stifling of innovation due to the inadequate protection of proprietary rights, heretofore protected by §282 of Title 35.

III THE SEVENTH CIRCUIT JUDICIAL RULE, REQUIRING A PATENT EXAMINER TO CITE IN THE ISSUED PATENT ALL THE ART HE HAS REVIEWED, IN ORDER FOR

THE PRESUMPTION OF VALIDITY TO BE RECOGNIZED, IS AN UNAUTHORIZED USURPATION OF ADMINISTRATIVE AUTHORITY AND SUCH AN ENCUMBRANCE UPON THE ISSUANCE AND ENFORCEMENT OF PATENTS AS TO PRODUCE A DE FACTO OVERRULING OF §282 OF TITLE 35 OF THE UNITED STATES CODE.

Congress has mandated that deference is to be given to the expertise of the administrative functions of the Patent and Trademark Office. Despite these directives the Seventh, Fourth and Second Circuits have held that they will refuse to recognize this special status if the party attacking the validity of the patent can find any art that was not "cited" in the issued patent by the patent examiner, notwithstanding the Patent Office Manual of Practice and Examining Procedure rule to not cite all the art looked at.^{14/}

^{14/} Patent Office Manual of Practice and Examining Procedure (M. P. E. P. §904.02).

The reasoning of these courts is two-fold. First, it has been held that to grant deference to the administrative expert that has not had the opportunity to "consider" the art being asserted against the validity of the patent would be to extend the rule beyond its purpose. Second, the patent office has been overworked and understaffed and therefore cannot be relied upon to have properly functioned in its expert capacity.

An analysis of the first reason for the "citing" requirement exposes that although there is logic behind requiring the Patent and Trademark Office to "consider" all the pertinent art if its expertise is to be recognized, a judicially imposed requirement of "citing" all the art searched is not the proper way to assure "consideration", and in fact imposes a burden on the patentee that is in violation

of the letter and spirit of §282.^{15/}

No court knows for certain whether the examiner has considered the art and discarded it or whether it was overlooked. It becomes necessary for the court to impose its opinion as to the art's pertinence. The court is then without the benefit of technical training, art familiarity, or available resources, put in the position of the patent examiner in resolving whether or not the art is relevant, a situation clearly outside the intent of §282. The judicial requirement to "cite" at first seems to be logical resolution. If the court is sure the patent office has seen the art it can refuse to place itself in the position of the examiner. In practice, however, the combination of the court's unfamiliarity with the standards of

^{15/} Burden shift, See, supra, pages 37-46.

invention, unfamiliarity with the claimed technology, and reluctance to hear patent cases because of their length and complexity, have made the requirement to "cite" a convenient tool for resolving patent cases. The ultimate result is many patents are being destroyed without regard to the legally required status given to patentees. The cure imposed by the Second, Fourth and Seventh Circuits is worse than the harm suffered.

"Infringers involved in patent litigation who cite prior art not cited by the examiner (even art that is not more pertinent than the cited art) have greater success in convincing courts to invalidate patents over such new prior art."^{16/}

^{16/} Draft Report, See footnote 10. Examples: Centsable Products Inc. v. Lemelson, 591 F.2d 400 (7th Cir. 1979); National Cash Register Corp. v. Eastman Kodak Co., 191 U.S.P.Q. 1941 (7th Cir. 1976); Chicago Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452 (7th Cir. 1975), cert. denied 423 U.S. 1091; Gettelman Mfg. Inc. v. Lawn 'N' Sport Power Mower Sales & Service, Inc.,

The second line of reasoning supporting the Second, Fourth and Seventh Circuit "cite" rule - the Patent and Trademark Office is so overworked that it cannot be relied upon to properly fulfill its function, undermines not only §282 but the entire patent system.

If the Patent and Trademark Office is presently overburdened, this additional judicially-imposed requirement of citing all prior art reviewed only adds to that burden, creating a virtually impossible task. Despite the line of cases in the circuits imposing the "cite" rule, the Patent and Trademark Office continues to follow the guideline in the Manual of

16/ (continued)
 517 F.2d 1194 (7th Cir. 1975); Lemelson v. Topper Corp., 450 F.2d 845 (2d Cir. 1971); Blumcraft of Pittsburgh v. Citizens and Southern Nat. Bank of S.C., 407 F.2d 557 (4th Cir. 1969), cert. denied 395 U.S. 961, reh. denied 396 U.S. 870, 396 U.S. 949.

Practice and Examining Procedure and do not "cite" all art reviewed to the detriment of inventors forced into litigation in a "cite" rule circuit.

Imposing sanctions (removing the protection of the presumption of validity) on patentees as the result of the Patent and Trademark Office not complying with the "cite" rule is an effort by the Second, Fourth and Seventh Circuits to fill the gap created by the alleged Patent and Trademark Office failure to function. The "cite" rule is an administrative rule created by these courts and given the effect of law. The Courts of Appeals have been given no authority to dictate Patent and Trademark Office operations. The failure of the Patent and Trademark Office to properly evaluate inventions, if it exists, is a legislative problem

not a judicial one.^{17/} Once it has been completed, Congress has said its actions must be presumed valid. This Court should exercise its supervisory power to assure the application of §282 and curb the courts of appeals usurpation of legislative power.

IV THE COURT HAS MISAPPLIED F. R. C. P. RULE 56 GRANTING SUMMARY JUDGMENT BY RESOLVING FACTUAL CONFLICTS RATHER THAN DETERMINING WHETHER ANY GENUINE ISSUE OF MATERIAL FACT EXISTED.

The District Court rendered the Lemelson patent invalid for obviousness upon the Plaintiff's Motion for Summary Judgment. In so doing, the court ruled by implication that there was no genuine issue of material fact in the case. Patent cases are particularly inappropriate to utilize summary

Congress is presently reviewing the Draft Report with its recommendations. See, supra, footnote #10, as noted by United States Senator Adlai Stevenson, Chairman of the Senate Commerce Subcommittee on Science and Technology.

judgment, in that numerous factual inquiries must be made before a decision on patent validity can be made.

To qualify for a patent, a new device must satisfy three conditions: novelty, utility and nonobviousness.^{18/} The ultimate question of patent validity is one of law. A&P Tea Co. v. Supermarket Corp., 340 U.S. 147 (1950). Obviousness is also a question of law grounded upon several factual determinations: the state of prior art, the claimed improvements on it.

In the landmark decision of Graham v. Deere Co., 383 U.S. 1 (1965), the Court noted the importance of a meticulous review of the factual aspects of the case in arriving at a determination of the question of obvious-

^{18/} 35 U.S.C. §§ 102, 103.

ness. That case set forth standards by which obviousness was to be judged:

1. What is the scope and content of the prior art?
2. What is the difference between the prior art and the claims at issue?
3. What is the level of ordinary skill in the art?^{19/}

These factual conclusions are measured against the standard of patentability, and the legal determination of validity is made.

The Court stated further that strict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act. Graham, see p. 40. Several

^{19/} Graham, supra, p. 40.

years later, the Court reiterated that strict compliance with the Graham v. Deere standards must be maintained.^{20/}

While some might consider a determination of patent validity a difficult problem, those difficulties are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter and should be amenable to a case by case development.^{21/}

These pronouncements highlight the need for exceptionally diligent attention by the district court to the facts in making a determination of patentability, and emphasize the limited applicability of F. R. C. P. 56 to patent

^{20/} Anderson's Blackrock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57, 62 (1969).

^{21/} Graham, supra, See page 40.

cases.^{22/}

Viewed in a broader perspective, the issue of obviousness is a mixed question of law involving the application of a legal standard to a particular set of facts. The issue of whether nonobviousness is a factual or legal question has precipitated much controversy within the field of patent law.^{23/}

The district court, upon a Motion for Summary Judgment by the plaintiff, ruled that the Lemelson patent in dispute was invalid for obviousness.

"After close examination of the Lemelson patent in the context of the

^{22/} Ag Pro, Inc. v. Sakraida, 437 F.2d 99 (5th Cir. 1971).

^{23/} Nonobviousness in Patent Law: A Question of Law or Fact? 18 WM. & MARY L. REV. 612 (1977). Subtests of 'Nonobviousness': A Non-technical Approach to Patent Validity, 112 U. PA. L. REV. 1169 (1964).

prior art, it is the Court's conclusion that it is invalid for obviousness under 35 U.S.C. 103." (District Court opinion, Appendix A.)

Several factual determinations were made by the district court in this decision.

1. A determination on the scope and content of prior art was made.

- a) The court found that the prior art cited by the plaintiff was more relevant than that considered by the Patent Office.

2. The difference between the prior art and claims at issue.

- a) The court found that the difference between prior art raised by plaintiff and claims at issue was not sufficient to meet the standard of patent ability.

3. The level of ordinary skill in the art.

- a) While the parties agreed that it was low, the court failed to make a qualitative analysis of factors involved at that level.

However, since this decision was based upon a Motion for Summary Judgment, the court found that no genuine issue of material fact existed in those areas. The court also failed to view the evidence in a light most favorable to Lemelson. It was boldly stated in the district court opinion,

"This potential factual difference does not create a genuine issue of material fact."

Although the courts are faced with a difficult decision in patent validity suits, testimony from experts in the particular scientific discipline is offered to educate the court on the technology involved in the patent. Witnesses skilled in the art offer their opinions as to whether the patent was obvious. In this case, the patentee did not have the benefits afforded by a trial i. e. availability of cross examination and opportunity to present complete evidence to properly educate the court.

Where the technology is not highly complex, other problems exist as aptly noted by Judge Learned Hand.

"Courts, made up of laymen as they must be, are likely either to underrate, or to overrate the difficulties in making new profitable discoveries in fields with which they cannot be familiar." ^{24/}

Particular problems were also noted by Hand in the use of summary judgment in patent matters.

"To judge on our own that this or that new assemblage of old factors was, or was not 'obvious' is to substitute our ignorance for the knowledge of those who are acquainted with the subject matter." Reiner v. I. Leon Co., 285 F.2d 501, 504 (2d Cir. 1960).

The scope of the prior art must be determined. Factual conclusions are drawn as to whether early prior art is relevant to

^{24/} Safety Car Heating & Lighting Co., Inc. v. General Electric Co., 155 F.2d 937, 939 (2d Cir. 1947).

the patent in question. Subtle distinctions and interpretations must be made as to the scope of claims.

"As certain 'terms of art' baffle anyone but the trained lawyer, many terms that the scientists may use or their patent lawyers may use can contain important distinctions imperceptible to anyone without an expert to explain or translate them."
Graver Mfg. Co. v. Linde Co., 336 U.S. 271.

In the instant case, the district court determined which patents were prior art. It also drew factual conclusions on the breadth and scope of those patents and their claims. A decision on the issue of the obviousness also requires that the court view the art at the time of the patent. A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the

time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.^{25/}

The factual determinations of the scope and content of the prior art, the difference between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art must be made without resorting to the teaching of the patent at bar or the deceptive and often unwitting use of hindsight.^{26/}

The Court also drew conclusions as to the differences between the uncited prior art and the claims at issue as required under Graham v. Deere standards. This would require interpretation of the claims in the

^{25/} 35 U.S. 103.

^{26/} Jamesbury Corp. v. U.S., 518 F.2d 1384 (Ct. Cl. 1975).

uncited prior art and comparison with the claims at issue. Yet, the court found no genuine issue of material fact existing in this complicated process!

Finally, the court stated that the parties agreed that the level of skill in the art was low. In other words, the court felt it was as competent as those skilled in the art and drew its own conclusions. This shows a lack of appreciation of the finer points, nuances of claims and terms of the art. Even though the level of skill was low in comparison to high technology areas, there are many qualitative aspects with which the Court would not be familiar and might overlook.

In short, the court found after meticulous review of the factual aspects inherent in a determination as to obviousness

that the evidence before them did not produce one single genuine issue of material fact when viewed in a light most favorable to the defendant. Such a result is virtually impossible in view of the numerous factual determinations inherent in patent cases. The defendant strongly contends that the court misapplied Rule 56 and substituted its own judgment on the evidence as a basis for its decision.

Rule 56 of the Federal Rules of Civil Procedure permits summary judgment prior to trial where there is no genuine issue as to any material fact.

"Rule 56(c), the [summary] judgment sought shall be rendered forthwith if [evidence on file] ... together with affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." 28 U.S.C. Rule 56.

The cases in other circuits are uniform in the application of Rule 56. The court has the power to penetrate the allegations of fact in the pleadings and look at any evidential source to determine whether there is any issue of fact to be tried.^{27/}

The trial court must determine whether a genuine issue of material fact exists rather than how that issue should be resolved.^{28/} The proper procedure in ruling on a Motion for Summary Judgment is not to resolve factual conflicts but to determine whether material issues of fact exist.^{29/} Trial by affidavit is no substitute for trial by jury

^{27/} Kirk v. Home Indemnity Co., 431 F.2d 554 (7th Cir. 1970).

^{28/} Cole v. Chevron Chemical Co., 427 F.2d 390 (5th Cir. 1970).

^{29/} Bouchard v. Washington, 514 F.2d 824 (D.C. Cir. 1975).

which so long has been the hallmark of "even-handed justice." Poller v. Columbia Broadcasting, 368 U.S. 464, 473 (1961). Summary judgment should not be used to try issues by affidavits.^{30/} Summary judgment should be cautiously invoked to the end that parties may always be afforded a trial where there is a bona fide dispute of facts between them. Associated Press v. U.S., 326 U.S. 1 (1944). The party moving for Summary Judgment has the burden of showing the absence of a genuine issue as to any material fact. Weinberger v. Hynson, Westcott & Dunning, 412 U.S. 609 (1972). The inferences to be drawn from the underlying facts contained in affidavits, exhibits, and depositions must be viewed in the light most favorable to the party opposing the

^{30/} Jaroslawicz v. Seedman, 528 F.2d 180, 188 (8th Cir., 1975).

Motion. U.S. v. Diebold, Inc., 369 U.S. 654 (1961).

It is easily seen that the district court in granting the Motion for Summary Judgment failed to understand the proper application of Rule 56. As such, this 7th Circuit decision is in conflict with the rule and case law in all other circuits.

Rule 56, in effect, makes a district judge an overseer of any determination. The responsibility of the judge is to determine whether there are issues to be tried, rather than to try the issues himself via affidavits. The judge's belief that the party against whom summary judgment is entered will not prevail is no reason for sustaining summary judgment. Jaroslawicz, at 731. A judge's role in determining summary judgment is somewhat limited.

"Judges may not leap beyond the boundaries marked by experts and declare as laymen in the art that a new article or design is either obvious or non-obvious." ^{31/}

The district court substituted its own judgment as to the relevance of prior art, the interpretation of claims, and level of skill in the art. It did not correctly apply Rule 56, but made its own judgment on the merits of evidence before it.

Summary judgment, when used wisely, is a timesaving device, "yet such prompt dispatch of judicial business is neither the role nor the primary purpose for which courts have been established... a party should not be deprived of an adequate opportunity to fully develop his case by witnesses and a trial, when the issues involved make such procedure

^{31/} Rains v. Cascade Industries, Inc., 402 F.2d 241, 247 (9th Cir. 1968).

an appropriate one. Tee-Pack, Inc. v. St. Regis Paper Co., 491 F.2d 1193, 1196 (6th Cir. 1974). As a tool to be used sparingly, summary judgment may be particularly inappropriate given "the importance of a patentee having a full and fair opportunity to litigate the validity of his patent."^{32/}

Summary judgment is particularly disfavored in patent cases because of their complexity. Moore Business Terms, Inc. v. Minnesota Mining & Mfg. Co., 521 F.2d 1178, 1185 (2d Cir. 1975).

A similar view is held in other circuits throughout the country. Referring to summary judgment, the Court stated in Tee-Pack, Inc. v. St. Regis Paper Co.: "This tool, however, should be used sparingly."

^{32/} Blonder-Tonque Laboratories v. University of Illinois, 402 U.S. 313 (1971).

Tee-Pack, Inc. v. St. Regis Paper Co.,
supra, at 1196. "Summary judgment is the
rare exception...and not the rule in patent
infringement cases." Ag Pro, Inc. v.
Sakraida, at 101. "Summary judg-
ment should be employed with great caution
in patent cases." Morpul, Inc. v. Glen
Raven Knitting Mill, Inc., 375 F.2d 732, 736
(4th Cir. 1966). Summary judgment for obvi-
ousness reversed. Intermountain Research
and Engineering Co., Inc. v. Hercules, Inc.,
406 F.2d 133 (9th Cir. 1969). The presence
of a single issue of material fact "precludes
disposition of a case by summary judgment."
Cee-Bee Chemical Co., Inc. v. Delco Chemi-
cals, Inc., 263 F.2d 150, 153 (9th Cir. 1959).
The circuit court concluded the district court
had indeed resolved at least one factual issue
in considering the prior art and the patentee's

improvements of it.

The showing made by the prior art, nature of improvement the patentee made over prior art, and the element of novelty are factual questions under 35 U.S.C. §103. Cole v. Chevron Chemical Co., 427 F.2d 390 (5th Cir. 1970). The court in this case made those factual conclusions.

Summary judgment thus has a very limited role in trade regulation cases and is "not appropriate where motive and intent play leading roles." White Motor Co. v. U.S., 372 U.S. 253, 259 (1963). "The issue of materiality [in summary judgment] may be characterized as a mixed question of law and fact, involving as it does the application of a legal standard to a particular set of facts. T.S.C. Industries, Inc. v. Northway, Inc., 426 U.S. 438 (1975). The Court continued,

"Only if the facts are so definite that reasonable minds cannot differ on the question of materiality is the ultimate issue of materiality appropriately resolved as a matter of law by summary judgment." id., at 450.

The patentee's burden in avoiding summary judgment is not heavy. "It is true that the issue of material fact required by Rule 56(e) to be present to entitle a party to proceed to trial is not required to be resolved conclusively in favor of the party asserting its existence; rather, all that is required is that sufficient evidence supporting the claimed factual dispute be shown to require a jury or judge to resolve the parties' differing versions of the truth at trial. The issue of fact crucial to petitioner's case is also an issue of law, namely the existence of a conspiracy. First National Bank v. Cities Service Co., 391 U.S.

253, 288-289 (1967).

The bottom line is that summary judgment is no substitute for trial.

"To obtain summary judgment, the movant must demonstrate the absence of any genuine issue of material fact, and the evidence submitted to the court 'must be viewed in the light most favorable to the opposing party'. Movant must show his right to a judgment with such clarity as to leave no room for controversy and that the other party is not entitled to recover under any discernable circumstances...In determining whether a genuine issue of material fact exists, the court must give the non-moving party the benefit of all reasonable factual inferences." Adickes v. S.H. Kress & Co., 398 U.S. 144 (1970).

"Summary judgment is the rare exception... and not the rule in patent infringement cases ...obviousness is a question of law determined against the factual background of the state of the prior art and claimed improvement in it." Ag Pro, Inc. v. Sakraida, 437

F. 2d 99, 101 (5th Cir. 1971).

The Court's decision and the overwhelming weight of case law is supportive of the Defendant's position that Rule 56 was misapplied by the court, and that summary judgment is inappropriate in patent validity cases.

While the importance of this case to the patent law field was discussed earlier in this petition, it must also be recognized that the courts of the Seventh Circuit are among the most active circuits with regard to patent litigation.

Of other particular significance is that the use of summary judgment is being widely touted as an inexpensive shortcut to a decision in patent suits. However, its use should not cut off the rights of litigants.

Finally, this case's importance should

be recognized because of the broad application which the Rules of Civil Procedure have to all type of litigation in the Federal Courts.

CONCLUSION

Although the patent before this Court met with substantial commercial success, its technological improvement is of no particular social significance. However, the conflict resulting from the disregard of the presumption of validity and its integral connection with the present lack of reliance on the United States Patent System, is so perfectly framed as to provide this Court with the opportunity to take a major step toward re-establishing patent reliability without interference from extremely complex technology.

A writ of certiorari should issue to

review the judgment of the United States Court
of Appeals for the Seventh Circuit.

Respectfully submitted,

Counsel of Record

ARTHUR T. FATTIBENE
28 West 44th Street
New York, New York 10036
(212) 730-1220

Of Counsel

GLENN L. STEPHENSON
80 Park Avenue
New York, New York 10016
(212) 682-5944

GEORGE MacRAE
1725 Kirkwood Avenue
Merrick, New York 11566
(516) 378-6488

CHARLES A. RUSSELL
36 Centre Street
Concord, New Hampshire 03301
(603) 225-3185

APPENDIX A
DISTRICT COURT OPINION

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

CENTSABLE PRODUCTS, INC.,)
)
Plaintiff,)
)
vs.) NO.
) 75 C 3717
JEROME H. LEMELSON,)
CADACO, INC., SYNERGISTICS)
RESEARCH CORP., and INTER-)
NATIONAL MANUFACTURING)
& MARKETING CORP.,)
)
Defendants.)

MEMORANDUM OPINION AND ORDER

John Powers Crosley, District Judge

This action is brought by an alleged infringer of a patent seeking a declaratory judgment that the patent involved is anticipated by the prior art, 35 U.S.C. §102(e) or obvious to one skilled in the art, 35 U.S.C. §103. Before the Court at this time are 1) defendants' motion

to dismiss,^{1/} 2) a petition by Centsable Toys, Inc. to join as a party plaintiff, and 3) plaintiff's motion for summary judgment on the issue of patent invalidity. Because defendants' motion to dismiss, if granted, would be dispositive of the controversy, that motion will be discussed first.

Defendants' motion to dismiss is based on four grounds:

1) Plaintiff Centsable Products has transferred all its interest in the product in controversy to Centsable Toys, Inc., and there no longer exists the requisite case and controversy to justify declaratory relief (Count I);

2) Plaintiff is not the real party in interest (Count I);

^{1/} The motion to dismiss is a joint motion filed by all defendants with the exception of Cadaco, Inc.

3) Count II, based on pendent jurisdiction, because dismissal is appropriate when the primary federal claim (Count I) is dismissed; and

4) The entire complaint, because the Southern District of New York is a more convenient and appropriate forum.

This action was brought by Centsable Products, Inc. ("Products"). Products had a justiciable claim at the outset of this litigation.^{2/} After the filing of the complaint "Products" transferred all interest in the allegedly infringing product to Centsable Toys, Inc.

^{2/} The threat of an infringement action by defendants was sufficiently founded upon defendants' advertising campaign in which it was stated that "due to blatant infringements of the rights... we intend to protect our rights with all legal remedies." Super Products Corp. v. D. P. Way Corp., 546 F. 2d 748, 754 (7th Cir., 1976).

("Toys"). By the terms of the transfer agreement, "Toys" was granted an exclusive license to manufacture and sell the product for a two year period. "Products" agreed not to compete directly or indirectly with the "Toys" operation for a period of two years. Finally, it was agreed that for two years "Products" would receive 25% of "Toys" adjusted net earnings from the sale of the product.

As a result of this transfer, "Products" has moved for the joinder of "Toys" as a party plaintiff. Defendants object both to the continued presence of "Products" in this litigation and to the joinder or substitution of "Toys". Though \ defendants' objections ostensibly present two separate theories for dismissal, they are more appropriately viewed as components of one argument.

Defendants object to the participation

in this litigation by "Products" because it no longer has a sufficient interest in the litigation to warrant declaratory relief. The purpose of declaratory relief, defendants assert, is to avoid large accruals of damages for infringement while the patent holder procrastinates in bringing an infringement action. Since "Products" has transferred its interest, any liability for infringement prior to the transfer is fixed and there is no need for declaratory relief. Alamo Refining Co. v. Shell Development Co., 99 F.Supp. 790, 800 (D.C. Del., 1950). Further, defendants argue, the possibility of future infringement by "Products" has been foreclosed by the exclusive license and no competition clauses in the transfer agreement.

Assuming the correctness of this position, defendants next challenge plaintiff's Rule

25(c) motion. Defendants argue that a Rule 25(c) joinder or, as they perceive it, substitution is inappropriate because "Toys" is not the real party in interest. Defendants assert that M. W. Kasch Company ("Kasch") conceived, owns, controls and finances "Toys" and is accordingly the real party in interest, Rule 17 F.R.C.P. It appears from their brief that defendants do not object so much to the inclusion of "Toys" as to the exclusion of "Kasch". Defendants quite candidly admit that because it is "Kasch that has the cash"^{3/} its presence is preferable, and indeed necessary for the proper adjudication of this controversy.

Both the Constitution and Declaratory

^{3/} Defendants' Brief in Reply to Plaintiff's Opposition to Defendants' Motion to Dismiss, p. 4.

Judgment Act, 28 U.S.C. §2201 require that an actual controversy exist. The determining question therefore, is whether there exists a controversy of "sufficient immediacy and reality to warrant the issuance of a declaratory judgment". Maryland Casualty Co. v. Pacific Coal & Oil Co., 312 U.S. 270 (1941). Further, we must determine, in the exercise of discretion, whether joinder or substitution is appropriate.

Plaintiff "Products" is not presently manufacturing or selling the allegedly infringing product. Were defendants to bring an infringement action against "Products", presumably injunctive relief would not be granted. As defendants point out, the transferor's potential liability for infringement is "frozen". This fact is not altered, as plaintiffs suggest, by reason of "Products" right to receive 25%

of "Toys" net earnings. However, we are convinced that the legal relations of the parties to this action are still very much in doubt and would greatly benefit from a declaratory judgment.

35 U.S.C. §289 provides for a penalty against infringers which entitles a patent holder to recover the total profit derived from the infringement. In light of defendants' stated determination to pursue every legal avenue to redress infringements of their patent, the availability of the relief afforded by §289 is enough to support "Products" reasonable apprehension of an infringement action. Further, we find persuasive the fact that anti-trust and Lanham Act claims, alleged in the complaint, continue to be viable. This is quite a different situation than that found in Western Dairy Products, Inc. v. The Griffith

Laboratory, Inc., 177 U.S.P.Q. 677 (N.D. Cal., 1973), cited by defendants as dispositive. In the present case, the patentability of the challenged patent is central to those claims. This in itself would presumably be insufficient to warrant declaratory relief. However, in combination with the continuing threat of infringement litigation, it adds weight to plaintiff's assertion that declaratory relief is necessary to clarify and settle the legal relationship of the parties.^{4/} Cf., U.S. Industries, Inc. v. Norton Company, 71 CV 359 (N.D. N.Y., Feb. 15, 1977).

Defendants correctly argue that in an

^{4/} This result is not affected by the two year exclusive license and no competition clauses. These clauses, effective for a relatively short period of time, do not foreclose the possibility of future infringement and, of course, are totally irrelevant as to an action for profits. 35 U.S.C. §289.

action for declaratory relief, all parties having an interest in the controversy should be before the Court. Diamond Shamrock Corp., et al. v. Lumbermans Mutual Casualty Co., 416 F.2d 707 (7th Cir., 1969). "Products" continuing interest in the controversy warrants its continued presence before this Court. "Toys" as transferee of the named plaintiff's interest in the manufacture and sale of the product clearly has an interest which mandates its presence in this action. Rule 25(c) F.R.C.P. The presence of "Kasch" is not required by the rule.

Where an assignment of interest occurs during the pendency of an action, Rule 25(c), not Rule 17 is the controlling rule. Moore's Federal Practice, §25.08, p. 25-321. It is within the sound discretion of the trial court to order Rule 25(c) joinder

or substitution. "Toys", as a separate corporate entity, is the appropriate object of a Rule 25 joinder. The mere ownership of stock in or even control of the transferee by "Kasch" is insufficient to require "Kasch's" presence in this action. Gordon v. International Tel. & Tel. Corp., 273 F. Supp. 164 (N.D. Ill., 1967). In the absence of facts sufficient to "pierce the corporate veil", "Kasch" could properly insulate itself from liability for the actions of its subsidiary.^{5/} Califf v. Coca-Cola Co., 326 F. Supp. 540 (N.D. Ill., 1971).

Defendants also move to dismiss the entire complaint because there is presently pending a lawsuit in New York which involves

^{5/} That is, of course, presuming that "Toys" is a subsidiary of "Kasch". It is unclear from the record whether this presumption is warranted.

the same parties. Certainly, the mere existence of litigation elsewhere especially when the other action was filed after this case was filed, is no reason to dismiss a pending action in this district. Even construing defendants' motion as a motion to transfer pursuant to 28 U.S.C. §1404(a), defendants have presented absolutely nothing of substance which would justify disturbing plaintiff's choice of forum.

As to the pendent claim stated in Count II of the amended complaint, defendants' sole argument in support of their motion to dismiss is that dismissal of Count I necessarily results in the dismissal of Count II because jurisdiction over that count is dependent upon the existence of a viable federal claim. Because we disagree with defendants as to the disposition of Count I, we need not reach this issue.

Accordingly, defendants' motion to dismiss Counts I and II are denied, defendants' motion to dismiss or transfer the complaint is denied and Petitioner "Toys" is granted leave to join as a party plaintiff.

Having denied defendants' motion to dismiss, we must now address the issues presented in plaintiff's motion for summary judgment on the question of patentability.

The challenged patent is the Lemelson patent 3,032,345 ("Lemelson patent"). The Lemelson patent, granted May 1, 1962, is entitled "Target Game" and describes a Velcro dart game, or in the language of the patent:

A dart game comprising in combination, a target board having an outwardly presented face provided with a textile covering having a surface of a pile fabric having upstanding loops, and a dart having a forwardly presented blunt impact and provided

with a textile covering having integral outwardly extending stiff hooks and spines formed of broken loops of filament adopted for retentive imbedment in said surface upon contact therewith.

In layman's parlance, the patent purports to cover a game which is essentially a variation on the more traditional dart game. Rather than the traditional missile, or dart, with a sharp metal tip which is thrown at a wooden game board, the Lemelson patent describes a missile the tip of which is covered by Velcro,^{6/} which is thrown at a target

^{6/} Velcro, a commercially available product, has been patented by its inventor in the DeMestral Patent 2,717,437. As described in Lemelson's patent it "consists of two strips of flexible wool-like material one of which has a multitude of tiny hooks...with the other material consisting of ... multiple loops... When the surfaces of the material are brought together the hooks become engaged in the loops...and the net effect is to provide a means for holding one material against the other.

board covered with suitable fabric. Because of the adhesive nature of Velcro, the dart attaches to the board. It is the claim of the patent application that this device provides a dart game which is safe to use by young children and is therefore an improvement over the traditional target game.

Though the patent was granted in 1962, it was not commercially exploited until 1973 when defendants Synergistics and Cadaco took licenses from Lemelson and began manufacturing and merchandising products in accordance with the terms of the patent. Sometime thereafter, plaintiff "Products" without first obtaining a license, began manufacturing and selling a similar Velcro target game called "Flatheads". After what plaintiff perceived as a threat of infringement litigation by defendant,^{7/} plaintiff

^{7/} See discussion above, p. 2, fn. 2.

"Products" brought this action seeking a declaratory judgment of the patent's invalidity.

In the present motion for summary judgment, plaintiff asserts that the Lemelson patent is invalid as obvious to one having ordinary skill in art.^{8/} Obviousness, as a basis for a finding of patent invalidity is set out in 35 U.S.C. §103:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

^{8/} Plaintiff also argues that the Lemelson patent is invalid as anticipated by the prior art, 35 U.S.C. §102(e). Because our ruling on plaintiff's allegation of obviousness is dispositive, we need not reach that question.

The standard by which this court must evaluate plaintiff's claim of obviousness was enunciated by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1969). Quoting from the Congressional Report, the Court noted that:

An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent...If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented. 383 U.S. at 14-15.

Under the standard set out in Graham, a determination of obviousness can be made only after an evaluation of: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue and; (3) the level of ordinary skill in the art.

383 U.S. at 17.

In the present case, the parties agree that the skill in the art is low. Therefore, for purposes of this motion for summary judgment there is no dispute of material fact as to the question of level of ordinary skill in the art. It is necessary, however, to examine the nature, content and scope of the prior art to determine what it fairly taught one having ordinary skill in the art.

Extensive memoranda and exhibits have been filed in support of and in opposition to plaintiff's motion for summary judgment. Throughout, plaintiff has asserted that three previous patents made obvious the Lemelson patent.

The Chaffin Patent, 740,397

In 1903, William Chaffin received a patent for his "Conversational Game Piece".

The Chaffin patent describes a game which consists of a missile, which is thrown against and should adhere to a fibrous or hairy surface. In order to insure adhesion, the missile was constructed with a cockle-burr^{9/} "or in any suitable way" which could form a missile with "numerous outward-extending fine hooked projections or points". Attached to the missile was a small slip of paper. The purpose of the game, as set out in the patent, was to exchange questions, answers, etc., by throwing the missile with sufficient force to enable the missile to adhere on the clothing or hair of the players.

^{9/} A cocklebur is defined in Webster's Third New International Dictionary as: (1) a plant of the genus *Xanthium*; (2) the prickly fruit of a cocklebur that readily attaches itself to any passing object by means of the stiff hooked spines with which it is clothed.

As claimed by the patent, the Chaffin patent covered, inter alia:

... an article of manufacture, a game piece comprising a missile formed with numerous outward extending hooked prongs which are adapted to adhere to hairy surfaces....

The Krusi Patent, 1,538,640

In 1925, Max Krusi obtained a patent entitled "Adherent Missiles". The invention set out in the patent involved a "hand missile of the nature of a dart, javelin or shuttlecock." The purpose of the missile was the transmission of small, light articles, as favors, flowers, confections, etc. " While the inventor contemplated the use of a "natural thistle bur", the patent suggests that "an artificial bur may be used as within the scope and spirit of the invention." As in the Chaffin patent the primary component of the invention was a

bur representing a plurality of hooked barb elements adapted to engage a textile fabric and support the missile.

De Metral Patent, 2,717,437.

The third patent presented by plaintiff in support of its motion for summary judgment does not involve a missile game, but rather covers the now commonly-known Velcro or as titled in the patent, "Velvet Type Fabric and Method of Producing Same". This fabric, which was intended primarily as a "fastener for garments, curtains and the like" employs a hook-and-loop theory of adhesion whereby fabric comprised of a multitude of tiny synthetic hooks will adhere when pressed against a piece of fabric comprised of tiny synthetic loops.

Based on these three patents, plaintiffs argue for summary judgment. It is plaintiff's position that the missile game

covered by the Lemelson patent is merely a variation of the Chaffin and Krusi patents whereby defendants merely substituted an artificial bur, Velcro, for the natural cocklebur or thistle of those previous patents. In further support of this position plaintiff submits copies of two newspaper articles which describe Velcro as an artificial or man-made burr and chronicle the invention of Velcro which apparently had its genesis in DeMestral's annoyance with burrs that clung to his clothing and his dog after a hunting trip in the mountains.

Plaintiff's assertion of obviousness goes to the very heart of patentability. Plaintiff argues that the Lemelson patent covers, not an "invention" within the meaning of the Patent laws, but merely an obvious substitution of new material which was actually suggested

in the prior art.

In response, defendants argue that there exist in this case questions of material fact which prohibit summary relief. Beyond that, however, defendants address the merits of plaintiff's claim and argue that as a matter of law, the Lemelson patent is not obvious and accordingly is valid. In support of this position, defendants argue: (1) that the design covered by the patent fulfills a long-felt need in the art for a safe dart game; (2) that the Chaffin and Krusi patents are mere "paper patents" and should be given little or no weight in the court's determination of obviousness; (3) that the use of Velcro in the toy art was a new use worthy of a patent; (4) that in fact, this design was not obvious to plaintiff; (5) that the Lemelson design has enjoyed considerable commercial success;

(6) that the Lemelson patent has conferred a benefit on the public; and (7) that the toy industry, generally, has acquiesced in the patent's validity.

There is no question that summary judgment is warranted only when there exists no genuine question of material fact and a trial would be useless. Rule 56 F.R.C.P. It is only after a close scrutiny of the record that summary relief should be granted. This is particularly true in patent cases. However, summary judgment is not unheard of in patent cases. See cases cited in Namirowski v. Nabisco, 421 F. Supp. 349, 352 (N.D. Ill., 1976). Further, while there does exist a presumption of validity which makes summary relief all the more elusive, "there is no presumption of patent validity when the pertinent prior art was not before the patent examiner."

Namirowski, 421 F. Supp. at 352. An examination of the Lemelson patent shows that neither the Chaffin nor the Knusi patents were cited in the Lemelson application. Accordingly, no presumption of patent validity exists for the Lemelson patent.

After close examination of the Lemelson patent in the context of the prior art, it is the Court's conclusion that it is invalid as obvious pursuant to 35 U.S.C. §103. Though defendants have attempted to create the illusion of complexity as to the nature of the Lemelson patent, it is nothing more than an "obvious variation of established" target games.

In opposition to plaintiff's motion for summary judgment, defendants submitted an extensive history of the target game art. The primary difference between the Lemelson target game and the more traditional target

games is the substitution of Velcro for other, arguably less effective adhesive materials. While there are unquestionably differences between the Lemelson patent and the prior art which work an improvement in the art, "the gap between the prior art and [the Lemelson patent] is simply not so great as to render the [Velcro target game] non-obvious to one reasonably skilled in the art." Dann v. Johnson, 425 U.S. 219 (1976). It has long been established that substitution of a superior material for an inferior one in a known device is not invention, even though the new material more satisfactorily serves or performs the intended function of the old. Deller, Walker on Patents §112. There is no invention in the mere substitution of an improved material when it subsequently becomes available. Martin-Marietta Corp. v. The

United States, 373 F.2d 972 (U.S. Ct. of Cl., 1967). This is true even where, as in the present case, the material was known primarily in a different art. Cf. Haig Products, Inc. v. K. O. Lee Co., et al., No. 73 C 2896 (N.D. Ill., Oct. 15, 1975).

Defendants have pointed out a number of factual considerations which cannot be resolved on the record before us. These facts, however, involve "secondary considerations" of a type not "material" within the meaning of Rule 56. Where a record supports a finding of obviousness, secondary considerations such as commercial success, unsolved needs, failure of others, etc. cannot alter the result. Sakraida v. Ag Pro, Inc., 425 U.S. 273 (1976). Further, defendants' argument that a factual dispute exists as to the impact absorbing nature of Velcro which makes it unique to the

patented target game is without merit. As plaintiff points out, this "new use" of Velcro is not mentioned in the Lemelson patent. Because it is the "claim of the patent [which] measures the grant", Popeil Bros., Inc. v. Schick Electric, Inc., 356 F. Supp. 240, 252 (N.D. Ill., 1972), aff'd 494 F. 2d 162 (7th Cir., 1975), this potential factual difference does not create a genuine issue of material fact.

Accordingly, Summary Judgment on the issue of patent validity is granted. Judgment is entered for plaintiff.

/s/ John Powers Crowley
John Powers Crowley
United States District Judge

DATED: June 12, 1978.

APPENDIX B

OPINION OF THE COURT OF APPEALS

In the
United States Court of Appeals
For the Seventh Circuit

No. 73-1969

CENTSABLE PRODUCTS, INC.,

Plaintiff-Appellee,

v.

JEROME H. LEMELSON,

Defendant-Appellant.

Appeal from the United States District Court for the
Northern District of Illinois, Eastern Division.
No. 75-C 3717—John Powers Crowley, Judge.

ARGUED DECEMBER 4, 1978—DECIDED JANUARY 23, 1979

Before CUMMINGS, LAY* and WOOD, *Circuit Judges.*

CUMMINGS, *Circuit Judge.* In Count I of its amended complaint, the plaintiff Centsable Products, Inc. (Centsable) sued Jerome H. Lemelson and three licensees¹ un-

* Honorable Donald P. Lay, Circuit Judge of the United States Court of Appeals for the Eighth Circuit, sitting by designation.

¹ The licensees named were Cadaco, Inc., Synergistics Research Corp., and International Manufacturing & Marketing Corp. They have not appealed from the judgment holding Lemelson's patent No. 3,032,345 invalid.

der his U.S. patent No. 3,032,345 seeking a decree that the patent is invalid and not infringed by the dart game sold by Centsable. Counts II through IV claimed injury from the defendants' efforts to protect the assertedly valid patent; Count II asserted a pendent claim of unfair competition; Count III alleged a conspiracy under Section 1 of the Sherman Act (15 U.S.C. § 1); and Count IV was brought under the Lanham Act (15 U.S.C. § 1125(a)). Summary judgment was granted for Centsable on the issue of patent validity. Only that question is involved on this appeal.

The patent in question is entitled "Target Game" and is described in the key first claim² of the patent as follows:

"A dart game comprising in combination, a target board having an outwardly presented face provided with a textile covering having a surface of a pile fabric having upstanding loops, and a dart having a forwardly presented blunt impact end provided with a textile covering having integral outwardly extending *stiff* hooks and spines formed of broken loops of filament adopted for retentive imbedment in said surface upon contact therewith." (App. Tab 3, column 4, claim 1; emphasis added.)

The application for the patent was filed on April 7, 1959, and granted on May 1, 1962, over an interference with Kenneth Marion's patent application claiming substantially the same combination as Lemelson. Ned Strongin developed a similar dart game in 1958 but did not file a patent application because a patent attorney advised him it was unlikely that he could obtain any patent.

In granting Centsable's motion for summary judgment, the district court filed a memorandum opinion holding that Lemelson's patent No. 3,032,345 was invalid

² Remaining claims 2-6 of the Lemelson patent are within the scope of claim 1, adding primarily that the dart could be of various shapes or that a ball could be substituted for the dart. Lemelson has not shown that these claims add any considerations material to the validity of the patent.

No. 78-1969

3

for obviousness under 35 U.S.C. § 103.³ Judge Crowley noted that the Lemelson patent describes a dart or missile whose tip is covered by Velcro manufactured under the 1955 DeMestral patent No. 2,717,437.⁴ As described in Lemelson's patent, Velcro

"consists of two strips of flexible wool-like material one of which has a multitude of tiny monofilament hooks * * * with the other material consisting of * * * a multitude of loops * * *. When the surfaces of the material are brought together the hooks become engaged in the loops and the net effect is to provide a means for holding one material against the other * * *."

Under Lemelson's patent, the dart is thrown at a target board covered with a suitable looped fabric, and the hooked dart attaches to the target board because of the adhesive nature of the hooked Velcro fabric which is also employed at the end of the dart. As Lemelson stated in his patent application, his device provides a dart game which is safe for use by young children and thus an improvement over earlier games of this sort.

In his memorandum opinion, the district judge stated that Centsable's claim of obviousness must be evaluated under the standards adopted by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, requiring an evaluation of the scope and content of the prior art at

³ 35 U.S.C. § 103 provides:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

⁴ Lemelson cannot properly assert that his claims include a novel resilient shock-absorbing feature, for that is merely a property of the already patented and commercially available Velcro and in any event is contrary to the recitation in claim 1 of "stiff hooks and spines" (App. Tab 3, column 4, claim 1).

the time of the invention, the differences between the prior art and the claims at issue and the level of ordinary skill in the art.⁵ Because the parties agreed that the skill in the art is low, the district judge found it necessary only "to examine the nature, content and scope of the prior art to determine what it fairly taught one having ordinary skill in the art and then apply [said] art to the claims" (App. Tab 2, p. 12).

We agree with the district court that no genuine issue of material fact is presented, so that summary judgment on the question of obviousness was appropriate. *Research Corporation v. Nasco Industries, Inc.*, 501 F.2d 358, 362-363 (7th Cir. 1974), certiorari denied, 419 U.S. 1096. We affirm on the ground of obviousness and therefore, like the district court, do not consider whether the Lemelson patent is also invalid under 35 U.S.C. § 102 as anticipated.

As the district court found, the most important prior art was not before the patent examiner, so that there is no presumption of validity as to the Lemelson patent. *Rockwell v. Midland-Ross Corporation*, n.5 *infra*, at 650. *Appleton Electric Co. v. Efengee Electrical Supply Co.*, 412 F.2d 579, 581 n.4 (7th Cir. 1969). The patents cited by the Patent Office did not show darts with hooking elements or teach the nature of Velcro as an artificial bur.

Here the relevant prior art was demonstrated by three patents, two publications and the contemporaneous work

⁵ Lemelson attacks the district court opinion as not explicitly evaluating the patent claims in light of the criteria set out in *Graham v. John Deere Co.*, 383 U.S. 1, 17. On the contrary, it is clear that the district court did properly apply that case. As we said elsewhere:

"Plaintiffs are subverting the substance of the ultimate findings to their form. The court [in *Graham v. John Deere Co.*] established the matters to be considered in a conclusion of obviousness, not the words the findings should use. We deem it sufficient if the findings demonstrate that the trial court considered the issues set forth in *Graham v. Deere*."

Rockwell v. Midland-Ross Corporation, 438 F.2d 645, 651 (7th Cir. 1971).

No. 78-1969

5

of two other persons. The 1903 Chaffin patent No. 740,397, which was not before the patent examiner, covers a game in which a cocklebur missile, with a slip of paper to steady the missile in its flight, is thrown to adhere to a fibrous hairy surface. Krusi's 1925 patent No. 1,538,640 was also not before the patent examiner. It covers, *inter alia*, a thistle bur attached to an artificial blossom or other light object to be thrown to a textile fabric surface, with the petals guiding the dart. Although a natural thistle bur is illustrated in Krusi's patent, he suggested that an artificial bur might be used within the scope and spirit of the invention.

DeMestral's 1955 patent No. 2,717,437 was cited to the patent examiner. It describes a hooking material and its manufacture. This material is a velvet type fabric comprised of a multitude of tiny synthetic hooks which will adhere when pressed against a piece of fabric comprised of tiny synthetic loops. The two types of fabric together compose Velcro.

In August 1958 the *Chicago Daily News* carried an article which described Velcro as comprising synthetic burs consisting of two strips of nylon material, one composed of tens of thousands of microscopic hooks and the other composed of tens of thousands of microscopic loops. A similar article appeared in the March 1959 *Reader's Digest*. Both articles described how the inventor was inspired by the tenacious hold of cockleburs in his dog's hair, and how he copied the hooking principle of natural burs to create Velcro. Neither article was before the patent examiner.

Lemelson's experimentation was from December 1958 to April 1959. As to the contemporaneous work of others, in 1958 Ned Strongin conceived of a Velcro-tipped dart game and licensed a company to sell it until 1963. As previously noted, he did not seek a patent thereon because of the negative advice of patent counsel. Substantially contemporaneously with Lemelson, Kenneth Marion filed a patent application claiming approximately the same combination as Lemelson. The patent office declared an interference resulting in the

issuance of the patent to Lemelson because of his priority.

The foregoing materials convinced the district judge and convince us that the Lemelson patent is only a variation of the Chaffin and Krusi patents, whereby Lemelson merely substituted an artificial bur for the natural cocklebur of the previous patents. As Centsable contends, Lemelson's patent is merely an obvious substitution of new material which was actually suggested in the prior Krusi patent and in Strongin's 1958 target game using Velcro. Lemelson's substitution of Velcro for other less effective adhesive materials would certainly be obvious to one reasonably skilled in the art (see *Dann v. Johnston*, 425 U.S. 219, 229-230) and is not invention. *Martin-Marietta Corporation v. The United States*, 373 F.2d 972, 977 (Ct. Cl., 1967). The general rule is that substitution of materials is not invention, even when the substitution is new and useful. 2 *Deller's Walker on Patents*, § 112 (2d ed. 1964).⁶ Because Lemelson's claimed invention clearly "would have been obvious at the time the invention was made to a person having ordinary skill in the art" (35 U.S.C. § 103), the district judge properly concluded that he need not take into account secondary considerations such as commercial success, unsolved needs, or failure of others and the like. *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 278; *Research Corporation v. Nasco Industries Inc.*, *supra*, at 362.

⁶ Lemelson suggests that to hold his patent invalid would be tantamount to holding that mere substitution of existing materials is never patentable. We are cognizant that a mere combination of elements can lead to a patentable item if the result is sufficiently new and useful. *Ekstrom-Carlson & Co. v. Onsrud Machine Works, Inc.*, 298 F.2d 765, 770 (7th Cir. 1962). Here, however, the substitution or combination of elements was obvious because of the previously discussed patents and articles. The similar games developed before or contemporaneously with Lemelson's are further evidence that the combination was obvious.

Our holding Lemelson's patent invalid does not necessarily mean that other patents making use of Velcro are also invalid.

No. 78-1969

7

Summary judgment on the issue of patent validity is affirmed.

A true Copy:

Teste:

*Clerk of the United States Court of
Appeals for the Seventh Circuit*

APPENDIX C

KRUSI AND CHAFFIN PATENTS

UNCITED ART ASSERTED AGAINST
LEMELSON PATENTS

213-95R

May 19, 1925.

1,538,640

M. B. KRUSI

ADHERENT MISSILE

Filed June 3, 1922

Fig. 1.



Fig. 2.



Fig. 3.



Inventor

Max B. Krusi

By his Attorney

Charles L. Krusi

KRUSI
1,538,640

RECEIVED

Patented May 19, 1925.

1,538,640

UNITED STATES PATENT OFFICE.

MAX B. KROEL OF NEW YORK, N. Y.

ADHERENT MISSILE

Application filed June 3, 1922. Serial No. 265,624.

To all whom it may concern:

Be it known that I, MAX B. KROEL, a citizen of the United States, and a resident of New York in the county of New York and State of New York, have invented certain new and useful Improvements in Adherent Missiles, of which the following is a specification.

This invention relates to novelties adapted to be hurled as hand missiles of the nature of a dart, javelin or shuttlecock, confetti or the like, provocative of amusement, fun and surprise, and carry messages or light burdens as a confection.

The principal object of the invention is to provide means whereby such missiles are caused to engage and cling to the clothing of the recipient with surprising tenacity but without injury to the finest textile fabric.

Another purpose is to produce a missile that may be used as a flying vehicle for the transmission of small, light articles, as favors, flowers, confections, etc., and which will resiliently adhere to fabric surfaces until forcibly removed.

A further aim is in the provision of devices of this character for advertising and like purposes as distributed promiscuously at fairs, carnivals, field games, theatres and like gatherings, and which are essentially simple, cheap to construct, highly attractive in appearance and entirely safe to handle and use by young or old of either sex.

These objects are attained by the novel construction and combination of parts hereafter described in their preferred embodiments and shown in the accompanying drawing, forming a part of the disclosure, and in which:—

Figure 1 is a perspective view showing the simplest embodiment of the invention, being merely a blossom and bur artificially connected.

Figure 2 is a similar view of a modification in structure, showing an object representing a doll, as engaged with a bur.

Figure 3 is a longitudinal sectional view of the same.

This invention is based upon the fact that nature produces a wonderful structure peculiarly well adapted to engage with any sur-

face presenting striations, interstices or roughnesses of relative fine nature, particularly a woven fabric.

The family of plants known generically as thistles and specifically as burdocks, produces burs containing seeds and covered with a thorny calyx presenting a multitude of separate barbs or prongs lanceolate in shape, terminating in acute, needle-like points, bent re-entrantly outward into horny hooks adapted to penetrate and cling resiliently but most tenaciously to whatever they may seize upon.

A variety of such burs, known as teasels have long been made use of in finishing the surface of woven woolen cloth, producing a nap which no artificial substitute has ever equalled.

Smaller burs have from time immemorial been used by children to play, due to their peculiar inherent property of adhesion to the cloth fabric from which their clothing is made.

The hooked barbs of these burs are so shaped that they can be handled with impunity without scratching the cuticle of the hands in throwing or removing the same and even should a scratch occur, no harm results as the burs are non-poisonous in their nature.

The invention then consists in connecting such natural vegetable burs with the missiles, shaping the missile in accordance with its purpose and for convenience in handling and throwing.

While the missile obviously may be made in any appropriate form whatever, two are shown to illustrate the purposes set forth.

Referring now to Fig. 1 of the drawing, a blossom, as a rose or pink, either natural or artificial, is designated by the numeral 10, its center being inclosed within its petals and its stem or peduncle 11 severed closely at its end from the plant.

Connected to the end of the peduncle, by suitable cement, thread stitches or other convenient and efficient means, is the base portion of a thistle bur 12, the same being in a mature condition, either green or dry according to the season.

Obviously upon throwing the missile thus

1,538,040

made it will hurtle through the air, bur foremost, because the preponderance of weight is in the peduncle, while the petals act to guide the device in the manner of a feathered dart or shaft, and upon striking a textile fabric, even very lightly, the missile adheres by its barbs.

In the modification shown in Fig. 2, the bur 12 is shown as connected to a figure representing a doll, comprised of a relatively heavy head 14 having a flowing ruffled collar 15, below which is a loose skirt 16.

The head may contain confections 17 or the like and may be made of paper, cotton, etc., the remainder of the figure being paper, colored and ornamental as preferred or provided with any printed matter, as an advertisement.

In this case the head acts under the momentum imparted by the hand in throwing and the skirt to direct the missile, ensuring that the bur will strike the object aimed at, head on.

Other modifications in shape and semblance will readily suggest themselves.

While a natural thistle bur has been shown and described, it will be apparent that an artificial bur may be used as within the scope and spirit of the invention.

From the foregoing it will be seen that a simple device has been disclosed in the preferred forms of its embodiment, but it is not desired to restrict the details to the exact construction shown, it being obvious that changes, not involving the exercise of in-

vention, may be made without conflicting with the scope of the appended claims.

Having thus described my invention, what I claim as new and desire to secure by Letters Patent, is:—

1. As a new article of manufacture, a hand thrown missile including a relatively heavy solid confection, a unitary flexible fabric member connected to said confection adapted to trail thereafter, and a bur connected to the confection in advance thereof.

2. As a new article of manufacture, a hand thrown missile comprising a hollow head adapted to act as a containing vehicle, a heavy substance therein, a unitary skirt element trailingly attached to said head, and a bur arranged in advance of said head.

3. As a new article of manufacture, a hand thrown missile comprising a hollow head adapted to act as a vehicle, a weighty matter contained therein, a fabricated one piece skirt element trailingly attached to said head, and a bur arranged in advance of said head, said bur presenting a plurality of hooked barb elements adapted to engage a textile fabric and support the missile.

4. A missile comprising a succulent, valuable body composed of a plurality of overlapping elements connected at a common center, and a natural bur engaged to said body at the center thereof to extend oppositely outward from said elements.

In testimony whereof I have signed my name to this application.

MAX B. KRIST.

No. 740,337.

PATENTED OCT. 8, 1903.

W. CHAFFIN.
CONVERSATIONAL GAME PIECE.
APPLICATION FILED FEB. 14, 1902.

BY MODEL.

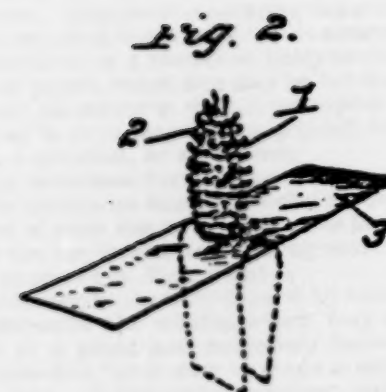


Fig. 3.



WITNESSES:

Edwin L. Yewer
R. A. Bishop.

INVENTOR

William Chaffin.
BY Daniel Davis.

ATTORNEYS.

No. 740,897.

Patented October 8, 1902.

UNITED STATES PATENT OFFICE.

WILLIAM CHAFFIN, OF HUNTINGTON, WEST VIRGINIA.

CONVERSATIONAL GAME-PIECE.

SPECIFICATION forming part of Letters Patent No. 740,897, dated October 8, 1902.

Application filed February 14, 1902. Serial No. 141,894. (No model.)

I, all whom it may concern:

Be it known that I, WILLIAM CHAFFIN, a citizen of the United States, residing in Huntington, county of Cabell, State of West Virginia, have invented certain new and useful improvements in Conversational Game-Pieces, of which the following is a specification, reference being had therein to the accompanying drawings, in which—

Figure 1 is a perspective view; Fig. 2, a similar view showing a slightly different form of inscription-clip attached to the missile, and Fig. 3 a similar view showing the inscription-clip folded about the missile.

The main object of this invention is to provide a novel game-piece for use in playing games in which slips of paper bearing suitable inscriptions are passed about among the players. It consists in securing to a missile—such as a cockle-bar, which is so constructed as to adhere to a fibrous or hairy surface—a slip of paper, which slip may be left blank to permit the player to write a message or question on it, or it may bear a printed inscription, a question, or an answer.

The invention further consists in securing to the missile an inscription-clip of very thin paper of such size as to permit it to be folded over the bar to form an inclosing cover therefor, as shown in Figs. 2 and 3.

Referring to the various parts by numerals, 1 designates the missile, which may be the seed of a plant and commonly known as a "cockle-bar," or it may be made in any suitable way. It is essential, however, that it be of such formation that it will adhere readily to woollen and hairy surfaces. As shown in the drawings, this missile is substantially elliptical in longitudinal section and is formed with numerous outward-extending fine hooked projections or points 2, which are designed to cause it to be held tightly to any hairy or woollen surface against which it is projected. To one end thereof is secured, preferably by glue, a strip 3, of paper or other suitable material. As shown in the drawings, the missile is secured about the middle of the strip; but of course it may be secured near one end thereof, if desired. By securing the inscription-clip to one end of the missile it will act as the feathers of an arrow or

dart and steady the missile in its flight and prevent its turning end for end, thereby enabling the player to throw it accurately. This clip may be left blank, if desired; but it is preferred to print thereon suitable inscriptions, questions, and answers—such, for instance, as "I am well pleased," "So am I," "I love you," "I hate you," "A hopeless case," "Only a suggestion," "As you like," "Are you on the market?" "You've captured me," "What a big nose," "My heart is yours," "You're a chump," &c. These may of course be varied indefinitely and may be arranged to suit all classes. In playing the game these missiles are thrown by the players on each other's clothing or in each other's hair with sufficient force to cause them to adhere. A player thus receiving a slip or "card" is expected to reply in the same manner with a card bearing a suitable reply-inscription.

In Figs. 2 and 3 the inscription-clip is shown broad enough to be folded about the missile to form an envelop therefor, its ends being twisted together to hold it in its folded position. In this way the bars or missiles are prevented from adhering together and may be easily carried in the pocket without danger of the inscription-clips being accidentally detached.

The inscription-clips may be of various colors, and the inscriptions may be printed in any desired style of type. Pictures may be printed on the clips, as is manifest.

The game-pieces may be used as an effective advertising medium by printing on the clips suitable advertising matter. It is also clear that more than one cockle-bar may be secured to the same strip, if desired.

The ends of the prongs of the missile are preferably slightly hooked, as shown more clearly in Fig. 2, to insure their clinging to a soft hairy surface.

Having thus described my invention, what I claim as new, and desire to secure by Letters Patent, is—

1. As an article of manufacture, a game-piece comprising a missile formed with numerous outward-extending hooked prongs which are adapted to adhere to hairy surfaces, and a light flexible inscription-clip secured thereto and bearing an inscription.

2

792,897

2. As an article of manufacture, a game-piece comprising a missile of substantially elliptical form in longitudinal section and formed with numerous small outward-extending hooked prongs adapted to hold it to a hairy surface, and a light flexible inscription-clip secured thereto at one end and bearing an inscription and serving to prevent the missile turning end for end during its flight.

3. As an article of manufacture, a game-piece comprising a missile formed with numerous small outward-extending prongs adapted to hold it to a hairy surface, and an inscription-clip secured thereto and adapted to be folded to form an envelop for the missile, its ends being adapted to be twisted to-

gether to temporarily hold the clip around the missile.

4. As an article of manufacture, a game-piece comprising a missile, and a light flexible inscription-clip secured thereto and adapted to be folded about the missile to form a cover therefor, its ends being adapted to be folded together to temporarily hold the cover about the missile.

In testimony whereof I hereunto affix my signature, in the presence of two witnesses, this 11th day of February, 1903.

WILLIAM CHAFFIN.

Witnesses:

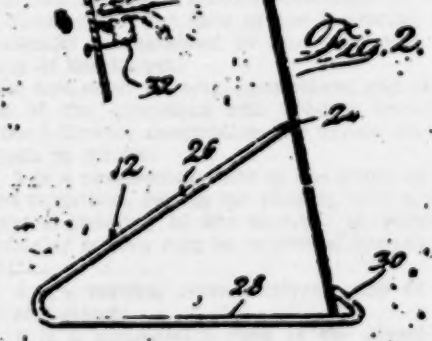
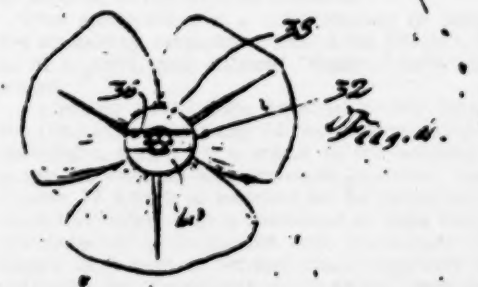
JOHN PERRY,

ELLIE CABELL.

July 26, 1949.

H. J. VOLMAN
MAGNETIC DART GAME
Filed Aug. 28, 1948

2,477,531



Inventor:
Harold J. Volman
By Shirley H. Hatten, Attorney
Attorneys

Patented July 26, 1949

2,477,531

UNITED STATES PATENT OFFICE

2,477,531

MAGNETIC DART GAME

Harold J. Volman, Cicero, Ill., assignor to Toy Enterprises of America, Inc., Chicago, Ill., a corporation of Illinois

Application August 22, 1948, Serial No. 64,834

12 Claims. (Cl. 273-95)

The present invention relates to games, an object of the invention being to provide a new and improved game simulating a dart game but capable of being played with blunt faced missiles so that the hazards incident to conventional dart games are eliminated.

Another object of the invention is the provision of a new and improved game provided with a target of magnetically susceptible material and missiles each having a permanently magnetized head which has sufficient magnetic energy to cause a missile to be sustained on the target when it is thrown toward the target and strikes the same.

A further object of the invention is the provision of a new and improved missile for a game of the character set forth in the preceding objects which is held to a target solely as a result of the magnetic attraction between the target and the missile.

A still further object of the invention is the provision of a new and improved missile as above set forth which is adapted to be freely propelled through the air and which has improved flight stabilizing or guiding means for maintaining the head of the missile foremost during flight.

More specifically, the invention relates to a game including a metallic target having a flat face, which target is formed of magnetically susceptible metal and the face of which target is provided with target indicia, thereon which one or more projectiles may be thrown, each projectile comprising a permanent magnet having a flat face, together with means such as a feather or a loop or the like for directing the projectile so that the flat face travels forwardly so that when thrown the flat face of the projectile will magnetically be attracted by and adhere to the flat face of the target.

These and other objects, advantages and capabilities of the invention will become apparent from the following description and accompanying drawings, in which:

Fig. 1 is a perspective view of the game of the present invention, set up for playing with a diagrammatic showing of the manner in which a projectile or missile may be propelled toward the target;

Fig. 2 is a vertical cross-sectional view of the target and stand;

Fig. 3 is a perspective view of the stand for supporting the target of my game;

Fig. 4 is a front end view of the preferred form of missile or projectile on an enlarged scale;

Fig. 5 is a fragmentary diametrical cross-sectional view on an enlarged scale of a missile on

the target, taken on the line 5-5 of Fig. 2;

Fig. 6 is a perspective view of a modified form of missile; and

Fig. 7 is a fragmentary perspective view of the missile shown in Fig. 6 indicating diagrammatically a manner in which a stabilizing feather may be secured to the head of a missile.

This application is a continuation in part of my copending application Serial No. 739,697, filed April 5, 1947, and entitled "Game," now abandoned.

Referring now to the drawing, it will be seen that the improved game of the present invention includes a target 10, a stand 12 for holding the target in substantially upright position, and a missile 14 which is adapted to be propelled toward the target and is sustained or held thereon magnetically upon impact with the target. The target 10, which is formed from relatively thin magnetically susceptible sheet metal, may be of any convenient size, for example, approximately one foot square. Preferably the peripheral edges of the target are flanged or beaded as indicated at 16 in Figs. 1 and 2 to provide smooth edges. The area within the beaded edge 16 forms a flat playing surface, all portions of which preferably should be in a common plane, and this face may be provided with any desired target indicia. In the present instance, which is purely for the purpose of illustration, the target is provided with top lettering 18 including the words "Bull's-Eye" and a centrally disposed target consisting of an inner circle or bull's-eye 20 and a plurality of concentric rings 22 surrounding the bull's-eye. The circles and rings may be contrastingly colored and may be marked with numbers indicating the scoring value to be assigned to each. If desired, the corners of the target outside the outer ring may be provided with other suitable indicia of any desired nature, or with a statement of the rules or instructions for play of the game. Since the target is made of magnetically susceptible sheet metal, the opposite sides thereof may be provided with different target indicia, that described above being merely illustrative.

This target is supported in substantially upright position, as indicated in Figs. 1 and 2, by means of the stand 12, best seen in Fig. 2. The stand is formed from relatively malleable wire rod to provide a horizontally extending back rest portion 24 and easel-like supporting structure on each end thereof in a plane normal thereto. Each of the easel-like supporting structures includes a leg 26 extending in an inclined plane rearwardly

from the back rest portion 34, and a feet 28 extending horizontally forwardly from the leg 25. The feet on the two easel-like structures lie in the same horizontal plane so that the stand may be set up on the floor or on a table top.

At their forward ends the feet terminate in upwardly projecting stop lugs 30 and preferably the feet 28 are somewhat longer than the legs 25 so that these lugs 30 will be positioned a slight distance forward of the back rest portion 34 when the stand is set up for use. As a result, the lower front edge of a target may be engaged behind the stop lugs 30 while the back side of the target engages the back rest portion 34 at a point somewhat above the bottom edge of the target. By reason of the fact that the feet 28 are somewhat longer than the legs 25, the target 18 is supported in a slightly rearwardly inclined plane, as best seen in Fig. 2, and thus is more stable than if it were supported in a vertical plane.

Another advantage of the stand described above arises from the fact that it may be made of malleable wire or rod and thus is easily formed. Furthermore, since it is malleable, it may be collapsed for packaging in relatively thin packages by bending the angularly disposed legs 25 downwardly toward the feet 28. Subsequently, when the game is to be used the parts may readily be bent to the position shown in Fig. 2.

One of the features of the present invention is the improved missile or projectile which I have devised for use in conjunction with the target above described. The preferred form of missile disclosed in Figs. 2, 4 and 5, has a generally disc-shaped head or body 32 of magnetically susceptible metal and stabilizing rudder means 34 for guiding the missile in flight extending axially rearwardly from the rear face of the head. In Figs. 4 and 5 it will be noted that the front side of the head is provided with a diametrically extending slot or kerf 36 of a depth approximately half the thickness of the head. Thus the head is provided with diametrically opposite generally segmental shaped flat forward faces 38 and 40 (Fig. 4), and because of the conformation of the head these faces acquire opposite polarity when the head is magnetized. In effect, the head becomes a horseshoe magnet with its opposite poles at the opposite faces 38 and 40, and the flux between these poles will be through the target when the front of the head strikes the target. Consequently a strong magnetic attraction between the missile and target is established. These pole faces also form a flat impact surface for direct contacting engagement with the target in a manner which will be described subsequently.

The stabilizing rudder means 34, previously mentioned, preferably consists of a plurality of feathers. Three feathers, arranged as shown, have been found to give satisfactory results. At one of their ends the quills of these feathers are fixed in an axially extending opening 42 (Fig. 5) in the head 32 by gluing the same therein with a suitable adhesive. The forward ends of the quills should of course be short of the plane of the pole faces 38 and 40 on the head so that they do not interfere with the direct contacting engagement between the pole faces 38 and 40 and the target.

When a stabilizing rudder means of the type above described is used, its effect upon the missile, upon release of the latter from a propelling means, such as the hand, is to immediately right the missile so that the front side of its head with the impact or pole faces 38 and 40, hereon, is

turned foremost irrespective of the position of these faces when the missile was released. Furthermore the effect of this rudder means is to maintain the impact or pole faces foremost throughout the flight of the missile so that these faces strike the target first.

Due to the fact that the head is magnetized and as a result of the front pole faces 38 and 40 striking the target first, a strong magnetic attraction between the missile and target is established which is sufficient rigidly to sustain the missile on the target at the point of impact and cause the missile to adhere to the target until manually removed.

Any desired number of missiles may be used with a single game and the stabilizing feathers may be variously colored to assist in identification by different players in computing the score. Suitable rules may be provided in accordance with the type of target used which, in addition to a bull's-eye, may depict any type of scene at which a projectile may be thrown, as, for example, a fort or a warship, or a plane.

A modified form of missile is disclosed in Figs. 6 and 7 wherein the projectile is shown as consisting of a permanently magnetized head in the form of a generally rectangular shaped block 44 having a relatively broad, flat front face 46. On its rear face, the block preferably has a sheet metal clip 48 (Fig. 7) soldered or welded thereto at a central position. The corners of this clip are folded along the dotted lines upon themselves so as to embrace the quill of a feather 50 which forms a stabilizing rudder for the missile. The feather is thus permanently secured to the head of the missile, as shown in Fig. 6. The effect of this feather upon the course of the missile in flight is generally the same as that previously described. A magnetized head of the type above described amounts in effect to a bar magnet with its two poles at opposite ends of the head. The flux lines between the poles will of course be through the magnetically susceptible target when the head impinges upon the target, and, as a result, the head will be made to adhere to the target.

It will thus be seen that I have provided a safe game for children to play because the missiles are not pointed like a game of darts. Furthermore, since the missiles do not have a point, they will not stick in walls, furniture or other objects if they miss the target, and thus will not cause damage accidentally because the head or bodies are light enough so that even if the missile strikes a piece of furniture, for example, it will not put a dent in the finish.

Obviously the invention is not limited to the specific details of construction disclosed herein but is capable of other modifications and changes without departing from the spirit and scope of the appended claims.

Having thus described the invention, what is claimed as new and desired to be secured by Letters Patent is:

1. A projectile adapted to be freely propelled through the air at a target of magnetically susceptible material having a flat playing surface, said projectile comprising a relatively thin generally disc-shaped permanently magnetized body having a slotted forward impact face defining symmetrically arranged relatively large flat areas of opposite polarity, and stabilizing means extending generally axially from the rear face of said disc-shaped body for maintaining the impact face foremost in flight, said body having

5

sufficient magnetic energy to sustain said projectile rigidly on said target when the impact face strikes said target.

2. A projectile adapted to be freely propelled through the air at a target of magnetically susceptible material, said projectile comprising a permanently magnetized body having a relatively broad impact face slotted to define symmetrically arranged relatively large flat areas of opposite polarity and said body also having an axial opening, and stabilizing rudder means affixed in said opening and extending generally rearwardly with respect to said impact face, said rudder means being effective to cause said flat impact face to be turned foremost during flight irrespective of the direction in which it faces at the beginning of the flight of the projectile.

3. A projectile adapted to be freely propelled through the air at a target of magnetically susceptible material, said projectile comprising a permanently magnetized body having a relatively broad impact face having a slot defining symmetrically arranged relatively large flat areas of opposite polarity, and stabilizing rudder means secured at one of its ends in said slot and extending generally rearwardly with respect to said impact face, said rudder means being effective to cause said flat impact face to be turned foremost during flight irrespective of the direction in which it faces at the beginning of the flight of the projectile.

4. A scoring piece adapted to be freely propelled through the air at a target having a substantially impenetrable playing surface of magnetically susceptible material, said scoring piece comprising a permanently magnetized body having a blunt target-engaging and adhering face including spaced areas of opposite polarity lying in a substantially common plane for making contact with and adhering to any portion of said playing surface and relatively lightweight rudder means attached to said body for stabilizing and guiding the scoring piece and maintaining said spaced areas foremost during flight, said rudder means extending generally rearwardly of said spaced areas, said body forming a sufficiently strong magnetic bond with a magnetically susceptible material to maintain the scoring piece substantially perpendicular to a playing surface formed of said material against the pull of gravity.

5. A scoring piece adapted to be freely propelled through the air at a target having a substantially impenetrable playing surface of magnetically susceptible material, said scoring piece comprising a permanently magnetized disc having a blunt target-engaging and adhering face including spaced areas of opposite polarity lying in a substantially common plane for making contact with and adhering to any portion of said playing surface, and relatively lightweight rudder means attached to said disc for stabilizing and guiding the scoring piece and maintaining said spaced areas foremost during flight, said rudder means extending generally rearwardly of said spaced areas, said disc having a diameter greater than the thickness of the disc and forming a sufficiently strong magnetic bond with a magnetically susceptible material to maintain the scoring piece substantially perpendicular to a playing surface formed of said material against the pull of gravity.

6. In a game, a target having a substantially flat impenetrable vertical playing surface of magnetically susceptible material, and a scoring piece adapted to be freely projected through the air at

6

said target, said scoring piece comprising a permanently magnetized body having a blunt target-engaging and adhering face including spaced areas of opposite polarity lying in a substantially common plane for making contact with and adhering to any portion of said playing surface, and relatively lightweight rudder means attached to said body for stabilizing and guiding the scoring piece and maintaining said spaced areas foremost during flight, said rudder means extending generally rearwardly of said spaced areas, said body forming a sufficiently strong magnetic bond with the magnetically susceptible material of said playing surface to maintain the scoring piece substantially perpendicular to said playing surface against the pull of gravity.

7. In a game, a target having a substantially flat impenetrable vertical playing surface of magnetically susceptible material, and a scoring piece adapted to be freely projected through the air at said target, said scoring piece comprising a permanently magnetized disc having a blunt target-engaging and adhering face including spaced areas of opposite polarity lying in a substantially common plane for making contact with and adhering to any portion of said playing surface, and relatively lightweight rudder means attached to said disc for stabilizing and guiding the scoring piece and maintaining said spaced areas foremost during flight, said rudder means extending generally rearwardly of said spaced areas, said disc having a diameter greater than the thickness of the disc and forming a sufficiently strong magnetic bond with the magnetically susceptible material of said playing surface to maintain the scoring piece substantially perpendicular to said playing surface against the pull of gravity.

8. A game comprising a target having a playing surface including a substantially flat area of magnetically susceptible material and a projectile including a relatively thin generally disc-shaped permanently magnetized body having a forward impact face slotted to define symmetrically arranged relatively large flat areas of opposite polarity, and stabilizing means extending generally axially from the rear face of said disc-shaped body for maintaining the impact face foremost in flight, said body having sufficient magnetic energy to sustain said projectile rigidly on said target when the impact face strikes said target.

9. A game comprising a target having a playing surface including a substantially flat area of magnetically susceptible material, and a projectile including a permanently magnetized body having a relatively broad impact face slotted to define symmetrically arranged flat areas of opposite polarity, said body having an axial opening, and stabilizing rudder means affixed in said opening and extending generally rearwardly with respect to said impact face, said rudder means being effective to cause said flat impact face to be turned foremost during flight irrespective of the direction in which it faces at the beginning of the flight of the projectile, said body having sufficient magnetic energy to sustain said projectile rigidly on said target when the impact face strikes said target.

10. A game comprising a target having a playing surface including a substantially flat area of magnetically susceptible material and a projectile including a permanently magnetized body having a relatively broad impact face having a slot defining symmetrically arranged relatively large flat areas of opposite polarity, and stabilizing rudder means secured at one of its ends in

2,477,551

7

said slot and extending generally rearwardly with respect to said impact face, said rudder means being effective to cause said flat impact face to be turned foremost during flight irrespective of the direction in which it faces at the beginning of the flight of the projectile, said body having sufficient magnetic energy to sustain said projectile rigidly on said target when the impact face strikes said target.

11. A projectile adapted to be freely propelled through the air at a target having a flat playing surface of magnetically susceptible material, said projectile comprising, a permanently magnetized body having a target engaging face including flat areas of opposite polarity lying in a substantially common plane, and flight-stabilizing means secured to said body and extending generally rearwardly with respect to said target engaging face for maintaining said target engaging face foremost during flight, said body having sufficient magnetic energy to form a sufficiently strong magnetic bond with a magnetically susceptible material to maintain the projectile substantially perpendicular to a playing surface formed of said material against the pull of gravity.

12. A game comprising a target having a playing surface of magnetically susceptible material and

8

a projectile adapted to be freely propelled through the air at said target, said projectile comprising, a permanently magnetized body having a target engaging face including flat areas of opposite polarity lying in a substantially common plane, and flight-stabilizing means secured to said body and extending generally rearwardly with respect to said target engaging face for maintaining said target engaging face foremost during flight, said body having sufficient magnetic energy to form a sufficiently strong magnetic bond with the magnetically susceptible material in the target to maintain the projectile substantially perpendicular to said playing surface against the pull of gravity.

HAROLD J. VOLMAN.

REFERENCES CITED

The following references are of record in the file of this patent:

UNITED STATES PATENTS

Number	Name	Date
1,826,812	Dey	Sept. 12, 1933
1,978,065	Forkner	Oct. 9, 1934
2,170,850	Bonnett et al.	Aug. 29, 1939
2,364,137	Olibb	Dec. 8, 1944
2,377,498	Jacke	June 5, 1945

Sept. 13, 1955

G. DE MESTRAL

2,717,437

VELVET TYPE FABRIC AND METHOD OF PRODUCING SAME

Filed Oct. 15, 1952

Fig. 1

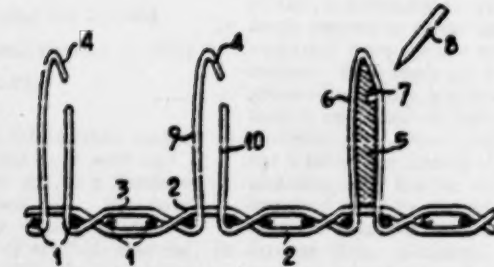
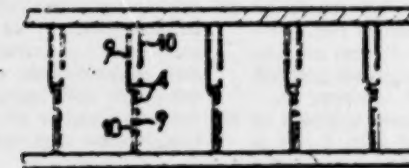


Fig. 2



INVENTOR

George de Mestral.

BY

ATTORNEY

1

2,717,437

VELVET TYPE FABRIC AND METHOD OF PRODUCING SAME

George de Mestral, Frangins, Vaud, Switzerland, assignor to Velcro S. A., Frimberg, Switzerland, a corporation of Switzerland

Application October 15, 1952, Serial No. 314,933

Claims priority, application Switzerland October 22, 1951

4 Claims. (Cl. 28—72)

My invention has for its object a velvet fabric including a foundation structure constituted by a weft and a warp incorporating threads that are cut at a predetermined length so as to form a raised pile. My novel fabric distinguishes from the other similar fabrics by the fact that the raised pile is made of artificial material, while at least part of the threads in said pile is provided near its end with material-engaging means, as required for adhering to a similar fabric or for scouring purposes.

My invention has for its further object a method for producing a fabric of the above type, according to which the raised pile is provided with its material-engaging means by forming loops round a carrier and submitting the loops formed on the carrier to a thermic action with a view to giving them their final shape, after which the loops are cut on one side of the carrier so that each loop produces at least one pile thread having a hook-shaped end.

Fabrics of the type referred to are intended primarily for use as closing means or fasteners for garments, curtains and the like as substitutes for the usual slider-operated closing means or fasteners or for buttons or the like attaching means, whenever a yielding invisible closing arrangement is of advantage.

Fabrics of the type referred to may also be used to advantage as cleaning implements. As a matter of fact, it is possible to lay them on a support made of wood or of plastic material so as to produce a clothes or shoe brush.

I have illustrated diagrammatically and by way of example in accompanying drawings various embodiments of the fabric according to my invention. In said drawings:

Fig. 1 is an explanatory diagram of a preferred method of production of such a fabric.

Fig. 2 shows two pieces of fabric executed according to a first embodiment of my invention and laid over each other so as to interengage and to adhere to each other.

Turning to Fig. 1, it is apparent that the velvet fabric, illustrated in the making, includes a foundation structure constituted by a weft 1 and by a warp 2.

The foundation structure also carries the warp thread 3 in addition to the warp thread 2, said thread 3 being adapted to form the raised pile 9, 10, some of the pile threads showing near their ends material-engaging means; in the example illustrated, the threads 9 of the pile are bent downwardly to form a hook 4.

Obviously, the weft and warp threads forming the foundation structure may be arranged otherwise than in the manner illustrated.

Furthermore, the raised pile is made of artificial or a synthetic resin material so that it is possible to give the pile threads the desired shape and to make them retain the said desired shape. I may use as an artificial material any suitable plastic material, such as that sold in the trade as "nylon", which is a generic term for any long chain synthetic polymeric amide which has recurring amide groups as an integral part of the main polymer

2

chain and which is capable of being formed into a filament in which the structural elements are oriented in the direction of the axis. Note "Du Pont Products Index," published by E. I. du Pont de Nemours & Company (Inc.), Wilmington 98, Delaware, page 91, January, 1951.

When producing a fabric of the type illustrated in Fig. 1, I proceed in the same manner as for the production of the special velvet made on bar looms. As a matter of fact, it is possible to use for the formation of the pile, small transverse metal bars (Fig. 1) round which the additional warp threads are caused to pass so as to form loops 6. Each small bar 5 is provided with a longitudinal groove 7 in which is guided a knife 8 adapted to cut the loop 6 open and to form thus the raised pile threads. However, with a view to obtaining the hooks 4, I heat the bar 5 before the cutting of the loops 6, so that the thread extending over the bar may assume and retain the shape imparted to it by the latter. The heating of the bars may be obtained by making an electric current flow through them. Obviously, the carrier bars 5 for the loop may be heated as well through any means other than an electric current, e. g. the carrier bars may be hollow and heated by steam.

After the loop 6 has been cut, the raised pile retains its shape and each loop produces, on one hand, the raised pile threads 9, the ends of which are hook-shaped and, on the other hand, ordinary raised pile threads 10 forming lost strands.

As apparent from inspection of Fig. 2, it is possible to superpose two pieces of fabric of the type illustrated in Fig. 1, after having imparted to one of the two pieces a 90° angular displacement in respect to the other piece and after turning them so that their pile surfaces face each other, the pile threads 9 of one piece engaging the pile threads 9 of the other piece through the co-operating hooks 4. Thus, as the number of hooks 4 per surface unit, say per square inch, may be high, the two pieces of fabric adhere together perfectly, and it is necessary to draw them away from each other with some energy, when it is desired to separate them. After separation of the two pieces, the hooks 4 return into their original shape.

It is thus possible to use a pair of such pieces of fabric to advantage as a substitute for the usual fastening means, such as slide-operated fasteners, ordinary buttons, press buttons or the like attaching means. As a matter of fact, it is sufficient to sew a piece of fabric of the type described along the edges of the parts of garments, curtains and the like, which are to be held together. A mere pressure exerted on the two garment elements against each other will provide for their fastening. A somewhat considerable tractional stress exerted on the two garment elements thus associated, allows separating them when required.

A fastening arrangement obtained as disclosed hereinabove shows inter alia the following advantages:

The possibility of compensating any clearance between the associated elements as such elements are not always in exact register with each other;

In the case of any straining, the fastening arrangement will yield before any damage is inflicted on the fabric, which is very important whenever a piece of velvet has engaged some fabric having delicate meshes.

It should be remarked that the velvet fabrics according to my invention and more particularly those illustrated in Figs. 1 and 2, may serve advantageously for the execution of household implements, such as clothes brushes, shoe brushes and the like cleaning or scouring means. Obviously, in such a case, the size of the threads and more particularly their thickness and their rigidity may be selected according to the purpose intended for the pieces of fabric that are to be executed.

2,717,487

3

The velvet fabric according to my invention is thus obtained in practice in a manner similar to a conventional velvet. However, it is obvious that my novel fabric has neither the silky feel nor the outer appearance of the usual velvet that serves for the execution of clothes or for upholstery.

1 claim:

1. A method for producing a velvet type fabric consisting in weaving together a plurality of weft threads and a plurality of warp threads together with a plurality of auxiliary warp threads of synthetic resin material, forming loops with said auxiliary warp threads on one surface of the so woven fabric, submitting the said loops to a thermal source, thereby causing said loops to retain their shape to form raised pile threads, cutting said loops near their outer ends, thereby forming material-engaging means on at least a portion of said pile threads constituted by said cut loops.

2. A method for producing a velvet type fabric consisting in weaving together a plurality of weft threads and a plurality of warp threads together with a plurality of auxiliary warp threads of synthetic resin material, forming loops with said auxiliary warp threads on one surface of the so woven fabric, submitting the said loops to a thermal source, thereby causing said loops to retain their

4

shape to form raised pile threads, cutting each of said loops near the respective outer end at a point between said outer end and the fabric surface, thereby forming a hook-shaped section with the free end of the respective pile thread at one side of said point at which the cut is made.

3. A velvet type fabric comprising a foundation structure including a plurality of weft threads, a plurality of warp threads, and a plurality of auxiliary warp threads of a synthetic resin material in the form of raised pile threads, the ends of at least part of said raised pile threads being in the form of material-engaging hooks.

4. A velvet type fabric comprising a foundation structure including a plurality of weft threads, a plurality of warp threads, and a plurality of auxiliary warp threads of a synthetic resin material in the form of raised pile threads, the terminal portions of at least part of said raised pile threads being in the form of a material-engaging means including hook-shaped sections.

References Cited in the file of this patent

UNITED STATES PATENTS

2,062,884	Holland	Dec. 1, 1936
2,662,559	Miller	Dec. 15, 1953

BEST COPY AVAILABLE

THE STATE OF CALIFORNIA, COUNTY OF LOS ANGELES, ss. I, the undersigned, a Notary Public in and for the State of California, do hereby certify that the within and foregoing is a true and correct copy of the original thereof, as the same appears from the records of said County, in and to which said original is on file and recorded.

WITNESS MY HAND AND SEAL OF OFFICE, this 1st day of January, 1911.

NOTARY PUBLIC IN AND FOR THE STATE OF CALIFORNIA.

APPENDIX E
AFFIDAVIT OF LEONARD S. KNOX

IN THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

78-1969

CENTSABLE PRODUCTS, INC.,)	APPEAL FROM
)	THE UNITED
)	STATES DIS-
Plaintiff-)	TRICT COURT
Appellee,)	FOR THE NOR-
)	THERN DISTRICT
vs.)	OF ILLINOIS,
)	EASTERN DIVISION
JEROME H. LEMELSON,)	
)	NO. 75 C 3717
Defendant-)	
Appellant.)	HONORABLE JUDGE
)	JOHN POWERS
)	CROWLEY PRE-
)	SIDING

AFFIDAVIT OF LEONARD S. KNOX

I, LEONARD S. KNOX, submit this
affidavit in support of Jerome H. Lemelson's
Petition for Rehearing and being duly sworn,
state as follows:

1. I received a Bachelor of Science Degree in Mechanical Engineering from the University of Minnesota in 1926 and Bachelor of Law Degree from the John Marshall School of Law in 1933. I am admitted to practice in the U.S. Patent and Trademark Office and have been practicing Patent Law since 1928 and am a member of the Illinois State Bar, admitted to practice in the Northern District of Illinois, and also admitted to the 7th Circuit Court of Appeals. I have obtained practical experience as a design engineer involving mechanical devices, toys and automatic machinery.

2. Since beginning my practice of Patent Law, I have prepared, prosecuted and dealt with hundreds of patent applications ranging from complicated electro-mechanical devices and instruments to toys and games,

and represented manufacturers of toys and games since the early 1950's. I have also been involved in patent litigation where the construction and interpretation of patents have been involved and I have testified as an expert witness in several patent suits for both patentees and accused infringers.

3. I recently received a copy of the Jerome H. Lemelson Patent No. 3,032,345 entitled "Target Game" which is the subject of this litigation. I have also reviewed all the reference patents listed on the last page of the '345 patent and which were cited by the Patent Examiner during prosecution of the application.

I have also received and carefully reviewed the Chaffin U.S. Patent 740,397 (1903) entitled "Conversational Game Piece" and reviewed the Krusi U.S. Patent 1,538,640

(1925) entitled "Adherent Missile". I have carefully studied the opinion of both the Lower Court and this Court in which reliance was placed upon the Chaffin and Krusi patents in invalidating the Lemelson patent.

4. After carefully studying the art cited by the Patent and Trademark Office and the Chaffin and Krusi patents, which were not cited by the Examiner, I am of the opinion that the Chaffin and Krusi patents are no more relevant than those patents which were cited. This opinion is based on the fact that the cockleburs of the Chaffin and Krusi patents will not function as stated, have insignificant mass, and may be compared to throwing a feather. Unlike the Lemelson device which provides a stabilizing, self-hooking, and safe projectile, the products of Chaffin and Krusi patents are virtually unrelated to the present

cause because of their impracticability. Also, the use of cockleburs presents an inherent, structural and operational difficulty in not only attaching a cocklebur to a projectile body, but also in operating or using the so-constructed projectile as a game. More specifically, cockleburs do not function as Velcro does and are quite different, as is obvious from the samples submitted with the Appellant's Opening Brief, page 9, which I have studied and which forms a portion of the basis for this opinion. Based on my analysis, I am of the opinion that the presumption of validity vested under 35 U.S.C. §282 should remain intact not having been overcome by clear and cogent proof.

5. During the 1950's and at the time of the filing of the '345 patent (April, 1959), I was actively involved with other

inventors in the toy and game field. Based on the admittedly low level of skill in the toy and game art at the time of Lemelson's invention, just prior to April, 1959, and based upon my study of the claimed invention of the '345 patent, and based upon the differences between the invention and the prior art, it is my opinion that under the tests for unobviousness enunciated in Graham v. Deere, 383 U.S. 117 (1966), the invention is unobvious.

/s/ Leonard S. Knox
Leonard S. Knox

March 8, 1979.

SUBSCRIBED AND SWORN TO
before me this 8th day of
March, 1979.

/s/ James J. Conlon
Notary Public